Supreme Court, U.S.
FILED

(1)

03 615 OCT 22 2003

No.

OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

TODD MCFARLANE, *et al.*
Petitioners,

v.

ANTHONY R. "TONY" TWIST,
Respondent.

On Petition for a Writ of Certiorari
To The Supreme Court of Missouri

PETITION FOR WRIT OF CERTIORARI

MICHAEL A. KAHN
Counsel of Record

GEOFFREY G. GERBER
BLACKWELL SANDERS
PEPER MARTIN LLP
720 OLIVE STREET
SAINT LOUIS, MO 63101
(314) 345-6496

CHARLES FRIED
1545 MASSACHUSETTS AVE.
CAMBRIDGE, MA 02138

EDWIN D. AKERS, JR.
GALLOP JOHNSON &
NEUMAN, L.C.
101 SOUTH HANLEY ROAD,
STE. 1600
SAINT LOUIS, MO 63105

STUART BANNER
UCLA SCHOOL OF LAW
405 HILGARD AVENUE
LOS ANGELES, CA 90095

St. Louis Law Printing, Inc. 14239 Manchester Rd. Manchester, MO 63011 314-231-4477

116 10

QUESTION PRESENTED

In a right-of-publicity case, does a work of expression that uses the name of a public figure in a non-defamatory manner lose its First Amendment protection if the money-making purpose of that expressive use outweighs what the court deems to be its "artistic value"?

PARTIES TO THE PROCEEDINGS BELOW

Petitioners are Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc., Todd McFarlane Entertainment, Inc., and Image Comics, Inc. They were defendants at the trial in the Circuit Court of the City of St. Louis, Missouri, and respondents in the Missouri Supreme Court.

Respondent is Anthony R. "Tony" Twist. He was the plaintiff in the trial court and the petitioner in the Missouri Supreme Court.

RULE 29.6 STATEMENT

The corporate petitioners have no parent corporations and no publicly held company owns 10% or more of their stock.

TABLE OF CONTENTS

QUESTION PRESENTED i

PARTIES TO THE PROCEEDINGS BELOW .. ii

RULE 29.6 STATEMENT ii

TABLE OF AUTHORITIES v

PETITION FOR A WRIT OF CERTIORARI 1

OPINIONS BELOW 1

JURISDICTION 1

RELEVANT CONSTITUTIONAL PROVISIONS INVOLVED 1

STATEMENT OF THE CASE 1

REASONS FOR GRANTING THE PETITION 9

I. The Decision Below Directly Conflicts With First Amendment Decisions By At Least Three Circuit Courts And The California and Kentucky Supreme Courts. 11

A. The "Transformative Use" Test in California and Elsewhere. 12

B. The "Relatedness" Test in the Second Circuit, Sixth Circuit and Kentucky Supreme Court. 14

C. The "Actual Malice" Test in the Ninth Circuit and Elsewhere. 16

II. The Decision Below Presents A First Amendment Issue Of National Importance In That It Chills Protected Speech Far Beyond Missouri's Borders. 18

III. Certiorari Is Warranted Because The Decision Below Allows Missouri Judges To Strip Core Speech Of First Amendment Protection If A Judge Decides That The Commercial Value Of The Expression Outweighs Its Literary Value. 21

IV. The Decision Below Satisfies The "Finality" Requirement And Chills Protected Speech In A Manner That Requires This Court's Prompt Attention. 23

CONCLUSION 27

TABLE OF AUTHORITIES

Cases:

Bleistein v. Donaldson Lithographing Co.,
188 U.S. 239 (1903) 21

Campbell v. Acuff-Rose Music, Inc.,
510 U.S. 569 (1994) 12

Cardtoons v. Major League Players Ass'n,
95 F.3d 959 (10th Cir. 1996) 14

Cohen v. California,
403 U.S. 15 (1971) 22

Comedy III Productions, Inc. v. Saderup,
21 P.3d 797 (Cal. 2001),
cert. denied, 534 U.S. 1078 (2002) 11-13

Cox Broad. Corp. v. Cohn,
420 U.S. 469 (1975) 23-24, 27

ETW Corp. v. Jireh Publ'n, Inc.,
332 F.3d 915 (6th Cir. 2003) 14

Flip Side, Inc. v. Chicago Tribune Co.,
564 N.E.2d 1244 (Ill. App. Ct. 1991)..... 18

Food Lion, Inc. v. Capital Cities/ABC, Inc.,
194 F.3d 505 (4th Cir. 1999) 18

Haelan Laboratories, Inc.
v. Topps Chewing Gum, Inc.,
202 F.2d 866 (2d Cir.),
cert. denied, 346 U.S. 816 (1953) 9

Harte-Hanks Communications, Inc.
v. Connaughton,
491 U.S. 657 (1989) 22

Hoffman v. Capital Cities/ABC, Inc.,
255 F.3d 1180 (9th Cir. 2001) 12, 16-17

Hustler Magazine v. Falwell,
485 U.S. 46 (1988) 19, 22

Miami Herald Publ'n Co. v. Tornillo,
418 U.S. 241 (1974) 26

Montgomery v. Montgomery,
60 S.W.3d 524 (Ky. 2001) 11, 16

New York Times v. Sullivan,
376 U.S. 254 (1964) 7, 17-19, 21, 23

Nike, Inc. v. Kasky,
123 S. Ct. 2554 (2003) (*per curiam*) 24-25

Parks v. LaFace Records,
329 F.3d 437 (6th Cir.), *petition for cert. filed*, No. 03-504 (U.S. Sept. 30, 2003)... 10-12, 16

Rogers v. Grimaldi,
875 F.2d 994 (2d Cir. 1989) 11, 15-16

Time, Inc. v. Hill,
385 U.S. 374 (1967) 19

Va. St. Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.,
425 U.S. 748 (1976) 17

White v. Samsung Electronics America, Inc.,
989 F.2d 1512 (9th Cir. 1993) 20-21

Winter v. DC Comics,
69 P.3d 473 (Cal. 2003) 11-14, 19

Winter v. New York,
333 U.S. 507 (1948) 22

Zacchini v. Scripps Howard Broadcasting Co., 433 U.S. 562 (1977) 6, 9-10

Constitution and Statute:

U.S. Const. Amend. I ..... *passim*

U.S. Const. Amend. XIV 1

28 U.S.C. § 1257 ..... 1, 23

Other Authorities:

J. Thomas McCarthy, The Rights of Publicity and Privacy § 1.3 (2d ed. 2003) 9

J. Thomas McCarthy, The Rights of Publicity and Privacy § 8.27 (2d ed. 2003) 10

Restatement (Third) of Unfair Competition § 47 cmt. c (1995) 7, 11, 14-15

Robert L. Stern, et al., Supreme Court Practice, § 3.5 (8th ed. 2002) 23

PETITION FOR A WRIT OF CERTIORARI

Petitioners Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc., Todd McFarlane Entertainment, Inc., and Image Comics, Inc. respectfully petition for a writ of certiorari to review the judgment of the Missouri Supreme Court in this case.

OPINIONS BELOW

The opinion of the Missouri Supreme Court (App. 1a-22a)[1] is reported at 110 S.W.3d 363, 67 U.S.P.Q.2d 1604, 31 Media L. Rep. 2025 (Mo. 2003) (*en banc*). The opinion of the Missouri Court of Appeals (App. 23a-61a) is reported at 30 Media L. Rep. 2409 (Mo. App. 2002). The opinion of the St. Louis Circuit Court granting petitioner's motion for judgment notwithstanding the verdict (App. 62a-80a) is unreported.

JURISDICTION

The Missouri Supreme Court entered its judgment on July 29, 2003. This Court has jurisdiction under 28 U.S.C. § 1257(a).

RELEVANT CONSTITUTIONAL PROVISIONS INVOLVED

The First Amendment to the U.S. Constitution, made applicable to the states by the Fourteenth Amendment, provides in relevant part: "Congress shall make no law... abridging the freedom of speech, or of the press."

STATEMENT OF THE CASE

This case involves the scope of First Amendment protection for works of artistic expression that use the name of a public figure in a non-defamatory way. The

---

[1] All references to the Appendix to this Petition shall use the abbreviation "App." followed by the page number, *e.g.*, "App. 1a."

Supreme Court of Missouri crafted what it acknowledged was a new test that conflicts with the existing ones and makes an expressive work's First Amendment protection depend upon a court's weighing the "artistic value" of the use against the publisher's "commercial" benefit from that use. In a market where publications are distributed nationwide, this uncertain and subjective test must chill the First Amendment rights of speakers everywhere.

The public figure is Respondent, a former National Hockey League player. The works at issue are a comic book series entitled *Spawn* and a Home Box Office ("HBO") animated show based on those comics. The Petitioners include the creators and publisher of those works.

Respondent sued Petitioners for violating his right of publicity on the ground that his nickname was used as the nickname of a fictional mobster in the comic book and HBO show. Petitioners argued at every stage of the case that the First Amendment barred Respondent's claim. The jury found in Respondent's favor and awarded him $24.5 million, which was greater than the net worth of all of the Petitioners.

The trial court granted Petitioners' post-trial motion and entered judgment in their favor notwithstanding the verdict. The Missouri Supreme Court reversed, holding that the works of expression receive no First Amendment protection.

Spawn

Spawn is the tale of a government assassin who is murdered just as he starts to question the morality of his job. Desperate to see his beloved wife one last time, he makes a deal to return to Earth, not knowing that the devil will send him back after his wife has remar-

ried and that he will be endowed with superpowers as a Hellspawn (a soldier in Hell's army).

One minor character who occasionally appears in the comic books is Antonio Carlo Twistelli. The fictional Twistelli was born in Sicily, joined the mob as an enforcer, and now lives in New York City, where he heads a crime syndicate. His nicknames are Don Dracula and Tony Twist.

Respondent was born in Canada, now lives in St. Louis, and once played professional hockey, where he gained some notoriety as an "enforcer" or "goon" (*i.e.*, a fighter). His nickname is Tony Twist.

It is undisputed that Respondent and Twistelli look nothing alike and share nothing in common except their nicknames and their roles as "enforcers" in their respective professions. They appear, side by side, below:

Respondent

Antonio "Tony Twist" Twistelli

(Trial Ex. MCF-FF.)

The Lawsuit

In 1997, Respondent filed suit in the Circuit Court of St. Louis against Petitioners and several other defendants, including HBO, a local comic book store, Blockbuster Video, and TCI Cablevision. (These other defendants settled or were dismissed pursuant to pre-trial motions.) The lawsuit alleged various claims, including defamation and right of publicity, arising out use of the name Tony Twist as the nickname of the fictional Twistelli character.

A year before trial, the court dismissed the defamation claim, holding that "a person of ordinary intelligence" would not understand the comic books "to convey factual assertions 'of and concerning' [Respondent]." (Mo. Sup. Ct. Legal File at 1006.)

No Petitioner ever published Respondent's likeness or otherwise used his likeness to promote any comic book or other product. Nor did any Petitioner publish any advertisement suggesting a connection between the fictional mob boss and Respondent. The only references to Respondent appear in the letters-to-the-editor section of the following two issues of the comic book published in 1994:

- In *Spawn* Issue 20, a letter noted that there were several "Quebec Nordiques in your stories." In his response, Todd McFarlane stated that the fan was "absolutely correct in noticing hockey players' names in my book," proclaimed that "I love hockey!" and provided "a list of some of the names I've used so far: Burke, Williams, Sakic, Twist, Linden, Roenick, and a few others I can't think of right now." (Trial Ex. 16, Issue 20.)

- Four issues later, in response to a fan's letter observing that some of the characters were named after real people, Mr. McFarlane explained that he was a big hockey fan and stated that "a lot of my characters have been named after current NHL players. For example, Antonio Twistelli a.k.a. Tony Twist is actually the name of a hockey player for the Quebec Nordiques." (*Id.*, Issue 24.)

The only other reference to Respondent was in an independent comic-book fan magazine entitled *Wizard*, which devoted a special issue to *Spawn*. For that issue, a reporter for *Wizard* wrote a feature on the origins of the names of various comic book characters. He testified that the information in his article came from his interview of Mr. McFarlane. In a paragraph in the article on the Twistelli character, the reporter identifies Respondent as "the real life persona" of the fictional character and states that Twistelli was named "for former Quebec Nordiques hockey player Tony Twist, now a renowned enforcer (*i.e.*, 'Goon') for the St. Louis Blues of the National Hockey League." (Trial Ex. 1.)[2]

Respondent tried the case solely on the right of publicity claim and solely on the use of his name. At the conclusion of a four-week trial, the jury returned a single verdict against all Petitioners for $24.5 million. The damage award was $24,482,000 more than Respondent had ever earned in annual endorsement income and was greater than the net worth of all the Petitioners. For example, Image Comics—a small publisher—was jointly and severally liable for an amount fifty times greater than the total net revenues it received from publishing all issues of *Spawn* and nearly

[2] The publisher of *Wizard* magazine was also a defendant but settled before trial.

five-hundred times greater than its annual net income for all of its publishing activities. (Trial Tr. at 562, 752-3; Trial Ex. F.)

Post-Trial Rulings and the Missouri Court of Appeals Decision

On post-trial motions, the trial court entered judgment notwithstanding the verdict ("JNOV") on various grounds. In the alternative, it granted a new trial if the JNOV were reversed on appeal. (App. 79a.)

The Missouri Court of Appeals affirmed the JNOV on First Amendment grounds:

> "To extend the right of publicity to allow a celebrity to control the use of his or her identity in a work of fiction would grant them power to suppress ideas associated with that identity, placing off-limits a useful and expressive tool. This, in turn, would effectively revoke the poetic license of those engaged in the creative process. To proscribe their right to use certain names, words, thoughts and ideas would ultimately apply to the rest of us, impeding our ability to express ourselves."

(App. 49a.)

The Missouri Supreme Court Decision

The decision below began its First Amendment analysis by looking to this Court's sole right-of-publicity decision, *Zacchini v. Scripps Howard Broadcasting Co.*, 433 U.S. 562 (1977). Although the Missouri court concluded that *Zacchini* did "not control the case at hand" because this Court had limited its holding to the unusual facts of that case (which involved the unauthorized television broadcast of Mr. Zacchini's entire 15-second "human cannonball" performance), it nevertheless read *Zacchini* to mean that media defendants in

right of publicity cases are not entitled to the same level of First Amendment protection afforded such defendants in libel, "false light," and other publication torts under *New York Times v. Sullivan*, 376 U.S. 254 (1964) and its progeny. (App. 14a-15a.)

The Missouri court acknowledged that right of publicity claims present a threshold First Amendment issue. In other jurisdictions, as the court explained, the issue is whether the accused speech is "expressive" or "commercial." If expressive, the First Amendment provides certain protections for the use of a celebrity's identity; if the speech is commercial, the use is not protected.

Conceding that the speech at issue here was expressive, the court examined what it characterized as the two principal tests used in other jurisdictions to distinguish between protected and unprotected speech, namely, the "relatedness" test under Section 47 of the Restatement (Third) of Unfair Competition and the "transformative use" test adopted by the California Supreme Court. (App. 17a-18a.)[3] Suggesting that Petitioners would prevail under either of those tests, the Missouri court rejected them both on the ground that "they give too little consideration to the fact that many uses of a person's name and identity have both expressive and commercial components." (App. 18a.) In the court's view, the problem under the existing tests was that "once the use is determined to be expressive, it is protected." (App. 18a.)

Instead, the Missouri Supreme Court announced a new First Amendment test, which it labeled the "predominant use" test. That test requires the court to

---

[3] Actually, there is a third First Amendment test—"actual malice"—that governs right of publicity claims in the Ninth Circuit and elsewhere. *(See* pp. 16-18, *infra.)*

examine the nature and the artistic merit of the expressive speech to determine whether the use of the public figure's name is predominantly for a commercial gain or for an expressive purpose.

In applying its new constitutional test to the comic books at issue, the Missouri court weighed the literary value of the use of Respondent's name against its commercial value. The court acknowledged that Mr. McFarlane testified that he liked the name Tony Twist because he thought it was "a pretty cool name," that it was "easy to remember," and that with that particular character "you always have a Twist ending." (App. 21a.) Moreover, given that Respondent and the fictional Twistelli had been "enforcers" in their respective professions, the court conceded that there was "an expressive component in the use of [Respondent's] name and identity as a metaphorical reference to tough-guy 'enforcers.'" Nevertheless, the court concluded, "the metaphorical reference to Twist, though a literary device, has very little literary value compared to its commercial value." (App. 19a.) Having rendered its artistic opinion, the Missouri Supreme Court concluded that "the use and identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity." (App. 19a.)

The court then turned to the state law issues and examined the jury instructions for compliance with the three elements of a Missouri right of publicity claim, which are (1) use of Respondent's name as a symbol of his identity, (2) without his consent, and (3) "with the intent to obtain a commercial advantage." (App. 20a.) The court concluded that there was a "fatal flaw" in the verdict director because of its "failure to properly in-

struct the jury on the commercial advantage element of the tort." (App. 20a-21a.) Specifically, the instruction did not include the intent requirement. "Because the verdict director allowed the jury to render a verdict for [Respondent] without a finding that [Petitioners] *intended* to obtain a commercial advantage, and because the jury may well have determined that [Petitioners] obtained a commercial advantage even though they did not intend to do so, the verdict must be set aside." (App. 21a; emphasis in original.)

Having stripped Petitioners of their First Amendment defense, the court reversed the JNOV and remanded the case for a new trial on the tort claim.

REASONS FOR GRANTING THE PETITION

The right of publicity was first recognized a half century ago in a decision upholding the rights of baseball players to prevent unauthorized use of their likenesses on baseball cards, *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953). The tort is now recognized—by statute or common law—in most States. J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1.3 (2d ed. 2003).

During the quarter of a century since *Zacchini v. Scripps Howard Broadcasting Co.*, 433 U.S. 562 (1977), the right of publicity has become the kudzu of publishing torts. Celebrities who are foreclosed by the "actual malice" standard from asserting other claims against publishers have turned to the right of publicity. As lawsuits have multiplied, the nation's state and federal courts have struggled to define the constitutional limits on a State's power to award damages to a public figure who sues the creator of a work of artistic expression.

Unfortunately, the unusual facts of *Zacchini* have

hindered the lower courts' abilities to seek guidance from it. As one leading scholar notes, "while the *Zacchini* majority and dissenting opinions have been picked apart word by word by the commentators, no clear message emerges and no general rule is discernible by which to predict the result of conflicts between the right of publicity and the First Amendment." McCarthy, *supra*, § 8.27. Meanwhile, the number of inconsistent reported decisions continues to increase. Indeed, during the two months preceding the decision below, the California Supreme Court and two separate panels of the Sixth Circuit handed down significant but inconsistent First Amendment decisions in this area, one of which is the subject of a pending petition for a writ of certiorari. *LaFace Records v. Parks*, No. 03-504 (U.S. Sept. 30, 2003 filed). (*See* § I, *infra*.)

Until the present case, the tension between the expressive rights embodied in the First Amendment and the property rights embodied in a celebrity's right of publicity had produced three tests for determining whether the speech at issue is protected. The decision below deepens that conflict by rejecting those tests and adopting a new and far less protective test that allows a court to exercise artistic judgment to convert an expressive work into an unprotected work of commercial speech. In turning judges into art critics, the Missouri Supreme Court cast off a crucial premise not only of the other three tests but also of this Court's First Amendment jurisprudence.

Creators of expressive works protected by the First Amendment in forty-nine states are now exposed to the risk of crippling liability in Missouri, whose watered-down version of the First Amendment sets the national standard for works of expression that evoke the identity of a public figure. The chilling impact of this is clear.

Books, movies, songs, comics, and television shows are distributed to a national audience. Scribners cannot publish a special Missouri edition of Stephen King's *The Girl Who Loved Tom Gordon* in which it substitutes an imaginary Boston Red Sox relief pitcher for the real one in the novel's title. Nor can there be a Missouri-only version of Simon & Garfunkel's "Mrs. Robinson" in which the recording studio bleeps out Joe Dimaggio's name or dubs in a generic "you great baseball star." As a result, protected expression will be self-censored as creators and publishers try to steer clear of a close encounter with one of Missouri's black-robed art critics.

This case offers the Court the occasion to clarify the confusion and conflicts in the post-*Zacchini* case law. But more urgently we submit that this Court should consider the anomalous decision of the Supreme Court of Missouri, which is more threatening to First Amendment values than any of the tests now in common use.

I. The Decision Below Directly Conflicts With First Amendment Decisions By At Least Three Circuit Courts And The California and Kentucky Supreme Courts.

Review is warranted because, as even the Missouri Supreme Court concedes, its "predominant use" test conflicts with the First Amendment tests adopted by other courts and by the RESTATEMENT (THIRD) OF UNFAIR COMPETITION. Specifically, the decision below conflicts with the more speech-protective tests adopted by the California and Kentucky Supreme Courts and at least the Second, Sixth and Ninth Circuits. *Comedy III Productions, Inc. v. Saderup*, 21 P.3d 797, 808 (Cal. 2001), *cert. denied*, 534 U.S. 1078 (2002); *Winter v. DC Comics*, 69 P.3d 473, 477-78 (Cal. 2003); *Montgomery v. Montgomery*, 60 S.W.3d 524, 535-36 (Ky. 2001); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); *Parks v.*

LaFace Records, 329 F.3d 437, 461 (6th Cir.), *petition for cert. filed*, No. 03-504 (U.S. Sept. 30, 2003); and *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1186-87 (9th Cir. 2001).

A. The "Transformative Use" Test in California and Elsewhere.

In seeking to balance the tension between First Amendment values and a celebrity's right of publicity, the California Supreme Court in *Comedy III* turned to the "transformative use" standard this Court articulated in the context of copyright "fair use" in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). In the copyright context, the test asks "whether the new work merely 'supersede[s] the objects' of the original creation or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is 'transformative.'" *Campbell*, 510 U.S. at 579 (citations omitted). As applied by the California court to the right of publicity, the standard becomes "a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation." *Comedy III*, *supra*, 21 P.3d at 799. In making that determination, the *Comedy III* emphasized that "courts are not to be concerned with the quality of the artistic contribution—vulgar forms of expression fully qualify for First Amendment protection." *Id.* at 809.

Earlier this summer in *Winter*, the California Supreme Court applied that test in what the Missouri Supreme Court admitted was "a case with a remarkably similar fact situation." (App. 17a) In *Winter*, two long-haired albino rock musicians, Johnny and Edgar

Winter, sued DC Comics over two long-haired albino comic book characters, Johnny and Edgar Autumn, who resembled the musicians and were advertised as such. The California Supreme Court dismissed the claim, holding that the comic books at issue "contain significant creative elements that transform them into something more than mere celebrity likenesses." *Winter*, 69 P.3d at 475.

As here, the plaintiffs in *Winter* contended that the comic books did not qualify as parodies. The California court dismissed the argument: "It does not matter which precise literary category the work falls into. What matters is whether the work is transformative, not whether it is parody or satire or caricature or serious social commentary or any other specific form of expression." *Id.* at 479.[4]

As even the Missouri Supreme Court concedes, the works at issue here would have First Amendment protection under the "transformative use" test. Petitioners' use of the Tony Twist nickname for a fictional New York mob boss is about as far from a "mere celebrity likeness" as one could imagine.

Moreover, the manner in which the Missouri court applied its test to the facts—namely, weighing artistic value against commercial value—directly conflicts with the California test, under which "courts are not to be concerned with the quality of the artistic contribution." *Comedy III*, *supra*, 21 P.3d at 809. Finally, the Missouri court's focus on what it characterized as efforts to market the work—*e.g.*, truthful responses to two letters to the editor, distribution of *Spawn* comic books at a

---

[4] The decision below erroneously states that Petitioners "agree" that their use of the Twist name "was not a parody." (App. 19a.) In fact, Petitioners contended that their use *was* a parody.

minor league hockey game—is forbidden under the California Supreme Court's test: "If the challenged work is transformative, the way it is advertised cannot somehow make it nontransformative." *Winter*, *supra*, 69 P.3d at 479.[5]

B. The "Relatedness" Test in the Second Circuit, Sixth Circuit and Kentucky Supreme Court.

As the Missouri Supreme Court explained, the "relatedness" test under Section 47 of the RESTATEMENT (THIRD) OF UNFAIR COMPETITION protects the use of a public figure's identity in a work that is "related to" that person. Specifically, Section 47—which defines what constitutes the use of a person's identity "for purposes of trade"—states that "use 'for purposes of trade' does not ordinarily include use of a person's identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses." Comment c to Section 47 elaborates on the scope and limits of such usage:

> The right of publicity . . . is fundamentally constrained by the public and constitutional interest in freedom of expression. The use of a person's identity primarily for the purpose of communicating information or expressing ideas is not gener-

[5] Versions of the "transformative use" test also apply in the Sixth Circuit and the Tenth Circuit. The Sixth Circuit relied upon it dismissing the golfer Tiger Woods' right-of-publicity claim against the artist and distributors of unauthorized lithographs featuring Mr. Woods. *ETW Corp. v. Jireh Publ'n, Inc.*, 332 F.3d 915 (6th Cir. 2003). As discussed below at § I.B., earlier this year the Sixth Circuit also adopted the "relatedness" test. The Tenth Circuit applied the parody component of the test to affirm dismissal of right of publicity claims brought by Major League baseball players against a company that created parody baseball trading cards using caricatures of their names and likenesses. *Cardtoons v. Major League Players Ass'n*, 95 F.3d 959 (10th Cir. 1996).

> ally actionable as a violation of the person's right of publicity. The scope of activities embraced within this limitation on the right of publicity has been broadly construed . . . . Use of another's identity in a novel, play, or motion picture is also not ordinarily an infringement. The fact that the publisher or other user seeks or is successful in obtaining a commercial advantage from an otherwise permitted use of another's identity does not render the appropriation actionable. However, if the name or likeness is used solely to attract attention to a work that is not related to the identified person, the user may be subject to liability for a use of the other's identity in advertising.

RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995).

In *Rogers*, the Second Circuit adopted the "relatedness" test to determine whether the First Amendment barred a right-of-publicity claim by actress-dancer Ginger Rogers against the creators of the film "Ginger and Fred." The film was not about Ginger Rogers and Fred Astaire but about two fictional Italian cabaret performers who imitated the famous dancing duo and become known in Italy as "Ginger and Fred." *Rogers*, 875 F.2d at 996-97. In applying the "relatedness" test, *Rogers* held that the title of the movie was protected by the First Amendment because it was not "wholly unrelated" to the movie and was not "simply a disguised commercial advertisement for the sale of goods and services." *Id.* at 1005. Under this test, an expressive work is protected unless either the use of the celebrity's name "has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, . . . the title explicitly misleads as to the source or content of the work." *Id.* at 999.

Earlier this year, the Sixth Circuit adopted the same test in a lawsuit by civil rights icon Rosa Parks over the use of her name as the title of a rap song. *Parks*, 329 F.3d at 451-52 (6th Cir. 2003). Quoting the "relatedness" test set forth in *Rogers* and Section 47 of the Restatement, the court defined the issue as whether the title of the song—"Rosa Parks"—"is or is not 'wholly unrelated' to the content of the song." *Id.* at 461. So, too, the Kentucky Supreme Court applied the test in a right of publicity lawsuit over the unauthorized use of a musician's name and likeness in a music video. *Montgomery*, 60 S.W.3d at 529-30 (citing *Rogers* and finding use of name and likeness to be "intimately related to the underlying work" and "not a disguised commercial advertisement").

Under the "relatedness" test, the *Spawn* comics have full First Amendment protection. The nickname Tony Twist is "related" and "artistically relevant" to the underlying work on several levels, ranging from the "enforcer" and "goon" metaphors to the allusion to "twist" endings. Moreover, the use of Tony Twist as a nickname of a minor character in the comics—as opposed to, say, the title of a rap song or a motion picture—can in no way be deemed to "explicitly mislead[ ] as to the source or content of the work." *Rogers*, 875 F.2d at 999. Nevertheless, the Missouri Supreme Court rejected this First Amendment test. (App. 18a.)

C. The "Actual Malice" Test in the Ninth Circuit and Elsewhere.

In *Hoffman*, actor Dustin Hoffman sued *Los Angeles Magazine*, claiming that an article on Spring fashions violated his right of publicity. The article featured stills from famous movies that had been altered to make it appear that the actors were wearing that season's fashions. One such still was of Mr. Hoffman in drag

from the movie *Tootsie.* In the altered version, Mr. Hoffman's head remained but his body had been replaced by the body of a male model in the same pose but wearing a silk evening gown and high-heeled sandals. The text read, "Dustin Hoffman isn't a drag in a butter-colored silk gown by Richard Tyler and Ralph Lauren heels." *Hoffman*, 255 F.3d at 1183. Although there were undeniably commercial aspects to the article, the Ninth Circuit determined that the publisher was "entitled to the full First Amendment protection accorded non-commercial speech" because the commercial aspects were " 'inextricably entwined' with the expressive elements, and . . . cannot be separated out 'from the fully protected whole.' " *Id.* at 1185-86.

The Ninth Circuit then turned to the issue of how to balance the right of publicity and the First Amendment in the context of an expressive work. It held that the appropriate test is the "actual malice" standard originally articulated by this Court in *New York Times v. Sullivan*, 376 U.S. 254 (1964). *Hoffman*, 255 F.3d at 1186. As applied to the facts before it, the court determined that Mr. Hoffman failed to prove that the publisher intended to create the false impression in the minds of its readers that "Hoffman himself posed for the altered photograph." *Id.* at 1187.

Significantly, the Ninth Circuit rejected Mr. Hoffman's contention that the existence of commercial elements in the article converted it into commercial speech. " '[T]here are commonsense differences between speech that does no more than propose a commercial transaction and other varieties,' *Va. St. Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771 n.24 (1976), and common sense tell us this is not a simple advertisement." *Hoffman*, 255 F.3d at 1185-86.

Under the "actual malice" standard, the *Spawn* comics and HBO series have full First Amendment protection. There was no evidence that any Petitioner intended "to create the false impression in the mind of its readers" that Respondent was actually a mob enforcer or otherwise connected with organized crime in New York or elsewhere. However, the Missouri Supreme Court deemed that test inapplicable to a right-of-publicity claim. (App. 16a.) Moreover, it rejected the Ninth Circuit's expressive/commercial speech divide by holding that a court could isolate a single element in the expressive work and apply its literary judgment to determine whether the use of the public figure was predominantly commercial.[6]

II. The Decision Below Presents A First Amendment Issue Of National Importance In That It Chills Protected Speech Far Beyond Missouri's Borders.

A celebrity seeking to file a right-of-publicity suit against a national publication or motion picture studio has the choice of many forums. While the elements of the cause of action vary little from State to State, the scope of First Amendment protection now varies greatly. The existence of conflicting First Amendment standards has a chilling impact on artistic expression, as

[6] The Ninth Circuit is not alone in holding that the "actual malice" standard governs *all* publishing torts. In a case involving the Dick Tracy comic strip, the Illinois Appellate Court held that under *New York Times v. Sullivan*, its dismissal of the defamation claim required dismissal of the related claims for invasion of privacy and intentional infliction of emotional distress because "the same first amendment considerations must be applied." *Flip Side, Inc. v. Chicago Tribune Co.*, 564 N.E.2d 1244, 1254 (Ill. App. Ct. 1991). *Accord Food Lion, Inc. v. Capital Cities/ABC, Inc.*, 194 F.3d 505, 522-24 (4th Cir. 1999)(First Amendment precludes award of publication damages for non-reputational tort claims unless plaintiff satisfies the proof standard of *New York Times*).

this case amply demonstrates. The *Spawn* comics and HBO series at issue here have no First Amendment protection in Missouri but full protection in California, Kentucky, and in the Second, Sixth and Ninth Circuits. By contrast, the First Amendment protects the comics at issue in the *Winter* case everywhere but in Missouri. This is an intolerable situation that deprives the freedoms of expression of the very "breathing space" this Court deems essential to their survival. *N.Y. Times*, 376 U.S. at 272.

Beginning with defamation, this Court has stepped into the realm of publication torts on several occasions to insure that the same version of the First Amendment applies throughout the nation. In *New York Times v. Sullivan*, the court surveyed various libel standards and held that "[t]he constitutional guarantees require . . . a federal rule that prohibits a public official from recovering damages for a defamatory falsehood relating to his official conduct unless he proves that the statement was made with 'actual malice' — that is, with knowledge that it was false or with reckless disregard of whether it was false or not." *N.Y. Times*, 376 U.S. at 279-80.

The Court extended that rule to the "false light" tort in *Time, Inc. v. Hill*, 385 U.S. 374, 390-91 (1967), and more recently to the tort of intentional infliction of emotional distress in *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988) (rejecting Virginia's "outrageousness" standard). The Court reiterated "that such a standard is necessary to give adequate 'breathing space' to the freedoms protected by the First Amendment." *Id.* at 56 (quoting *N.Y. Times*, 376 U.S. at 279-80).

The split in the courts underscores the need for a uniform First Amendment rule. Missouri is now the lowest common denominator of free speech in the area

of right of publicity. Its watered-down and inherently unpredictable test sets the *national* standard for works of expression that evoke the identity of a public figure. No prudent record producer could take the risk that a Missouri judge in, say, Grundy County, might decide that the commercial value derived by singer Kim Carnes from use of the name Bette Davis in the title and lyrics of her 1991 Grammy award-winning song "Bette Davis Eyes" outweighed the artistic value of that use. So, too, the makers of the motion picture "Searching for Bobby Fischer" would risk financial ruin in Missouri if they didn't change the title to "Searching for a Champion Chess Player." Indeed, if the name of a journeyman hockey player is worth $24.5 million, imagine the Missouri price tag on the most famous soccer player in the world, whose name is in the title of the current motion picture "Bend It Like Beckham." Many popular songs—including Madonna's "Vogue" and Billy Joel's "We Didn't Start the Fire"—use enough public figure names to populate a Missouri class action.[7]

Artists need assurance that what is protected in one State is protected in all States. As Judge Kozinski pointed out in his oft-quoted dissent from the order rejecting rehearing *en banc* in *White v. Samsung Electronics America, Inc.*, 989 F.2d 1512 (9th Cir. 1993),

> The First Amendment isn't just about religion or politics—it's also about protecting the free development of our national culture... The last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep

---

[7] The lyrics to "Vogue" include the stanza: "Greta Garbo, and Monroe/ Deitrich and DiMaggio/ Marlon Brando, Jimmy Dean/ On the cover of a magazine." The Billy Joel song lists the names of scores of public figures, including politicians, authors, singers, astronauts and actors.

people from mocking them, or from 'evoking' their images in the mind of the public.

Id. at 1519.

III. Certiorari Is Warranted Because The Decision Below Allows Missouri Judges To Strip Core Speech Of First Amendment Protection If A Judge Decides That The Commercial Value Of The Expression Outweighs Its Literary Value.

In *New York Times v. Sullivan*, 376 U.S. 254 (1964), this Court rejected the argument that the First Amendment did not protect false statements in a newspaper advertisement by civil rights activists seeking contributions to their cause. Pointing out that the advertisement also communicated information and expressed opinions on matters of public concern, the Court held "that if the allegedly libelous statements would otherwise be constitutionally protected from the present judgment, they do not forfeit that protection because they were published in the form of a paid advertisement." *Id.* at 266.

Four decades later, the Missouri Supreme Court has turned that holding on its head, ruling that works of artistic expression that would otherwise be constitutionally protected could forfeit that protection if a judge determines that the artistic value of an isolated excerpt from the work is outweighed by its commercial value. As Justice Holmes observed one hundred years ago, "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

Even putting aside the chilling effect of turning judges into art critics, the "predominant use" test violates two basic principles of this Court's First Amendment jurisprudence, namely, that the scope of protection does not depend upon the quality of the expression or the commercial intent of the speaker.

The Missouri Supreme Court's decision to make First Amendment protection depend upon a judge's opinion about the literary value of the expression violates a line of decisions running back at least to *Winter v. New York*, 333 U.S. 507 (1948), where the Court, in refusing to draw a First Amendment distinction between serious political advocacy and allegedly frivolous entertainment, warned: "What is one man's amusement, teaches another's doctrine. Though we can see nothing of any possible value to society in these magazines, they are as much entitled to the protection of free speech as the best of literature." *Id.* at 510. *See also Cohen v. California*, 403 U.S. 15, 25 (1971) ("it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual"); *Hustler Magazine v. Falwell*, 485 U.S. 46, 55 (1988) (extending First Amendment protection to caricature of nationally known minister portrayed as engaging in a drunken incestuous affair with his mother, despite fact that the work "is at best a distant cousin of the political cartoons described above, and a rather poor relation at that").

As for the irrelevance of the artist's commercial motives, this Court held that "[i]f a profit motive could somehow strip communications of the otherwise available constitutional protection, our cases from *New York Times* to *Hustler Magazine* would be little more than empty vessels." *Harte-Hanks Communications, Inc. v. Connaughton*, 491 U.S. 657, 667 (1989). Yet that is

precisely what the Missouri Supreme Court did here by sifting the evidence for a profit motive and using it to strip the comic books "of the otherwise available constitutional protection."

IV. The Decision Below Satisfies The "Finality" Requirement And Chills Protected Speech In A Manner That Requires This Court's Prompt Attention.

The Missouri court has announced a new First Amendment standard, applied it to the expressive works at issue, and declared that "free speech must give way to the right of publicity." (App. 19a.) There is no reason to defer review for the years (and the expense) it will take to complete the proceedings on remand.

Although this Court's jurisdiction is limited by 28 U.S.C. § 1257 to "final judgments or decrees" of the state courts, the Court has adopted a "pragmatic," rather than "mechanical," approach to determining whether a judgment is "final." *See Cox Broad. Corp. v. Cohn*, 420 U.S. 469, 477, 486 (1975); ROBERT L. STERN, et al., SUPREME COURT PRACTICE, § 3.5 (8th ed. 2002). This case satisfies all necessary elements of a final judgment under the *Cox Broadcasting* standard.

Cox Broadcasting, as here, involved a clash between First Amendment values and State tort law in the media context. The plaintiff had sued for violation of his right of privacy based upon defendants' publication of his daughter's name. *Cox Broad. Corp.*, 420 U.S. at 474. Rejecting the defendants' free speech defense, the state supreme court reversed summary judgment and remanded for a trial to determine whether defendants' conduct was willful or negligent. *Id.* at 474-75. This Court took jurisdiction and held that the First Amendment barred the plaintiff's claim. *Id.* at 496-97.

In accepting jurisdiction, *Cox Broadcasting* articulated the standards for determining when a federal question has been finally determined for jurisdictional purposes despite a remand for further proceedings. *Id.* at 477. Pertinent here is what the Court identified as the fourth category of "non-final" final judgments:

> [W]here the federal issue has been finally decided in the state courts with further proceedings pending in which the party seeking review here might prevail on the merits on nonfederal grounds, thus rendering unnecessary review of the federal issue by this Court, and where reversal of the state court on the federal issue would be preclusive of any further litigation on the relevant cause of action... [in] the state court proceedings still to come. In these circumstances, if a refusal immediately to review the state-court decision might seriously erode federal policy, the Court has entertained and decided the federal issue, which itself has been finally determined by the state courts for the purposes of the state litigation.

Id. at 482-83.

The decision below falls squarely within this analysis and stands in stark contrast to the decision last term to dismiss the writ of certiorari as improvidently granted in *Nike, Inc. v. Kasky*, 123 S. Ct. 2554, 2555 (2003) (*per curiam*). Indeed, the finality factors here are even more compelling than those in *Cox Broadcasting* itself. *Nike* came before this Court after a dismissal at the initial pleading stage. None of the allegations in that case had been tested in discovery, and the scope and nature of the speech at issue had not been completely defined or determined. *Cox Broadcasting* came before this Court after the state supreme court reversed a grant of summary judgment and remanded for trial on the merits.

By contrast, here there has been a full trial on the merits. Claims, evidence and issues have been examined and narrowed through years of discovery and extensive pretrial motion practice. Respondent has fine-tuned his claims in pleadings that he amended more than once. The record below was established in a several week jury trial. The parties thereafter refined and tested their theories in post-trial motions and appeals.

The existence of both a full record and a large body of appellate decisions on the constitutional issue combine to eliminate the other jurisdictional concern Justice Stevens expressed in his concurring opinion in *Nike,* namely the Court's reluctance to "anticipate" novel and important constitutional questions. Although Justice Stevens agreed that questions concerning the scope of protection for the speech at issue in *Nike* "are questions that may have to be decided in this litigation," he stressed that "[t]he correct answer to such questions, however, is more likely to result from the study of a full factual record than from a review of mere unproven allegations in a pleading." *Nike, supra, 123* S.Ct. at 2559. Here, that full record already exists. Moreover, as the myriad appellate decisions around the nation attest, the constitutional issue is no longer novel.

In short, the federal question in this case has been fully aired and finally adjudicated by the state courts. Specifically, the Missouri Supreme Court (a) examined the trial evidence, (b) rejected the prevailing First Amendment standards that would have prohibited Respondent's claim, (c) articulated the standard to govern all right of publicity cases in Missouri, (d) applied that standard to the facts established by the trial record, and (e) held that "free speech must give way to the right of publicity." (App. 19a.)

Having stripped Petitioners of their First Amendment defense, the Missouri court left no federal issue to be resolved on remand. Accordingly, if Petitioners prevail on the remaining nonfederal grounds, that would render unnecessary any review by this Court of the First Amendment concerns raised by the Missouri Supreme Court's decision. The "predominate use" test would thus remain the law in Missouri and chill protected expression far beyond its borders.

If this Court were to reverse the decision below on First Amendment grounds, the case would end. But a refusal to review the decision below will seriously erode federal constitutional policy favoring free speech. The extent to which the First Amendment limits the ability of the States to impose liability for nondefamatory uses of a public figure's name in a work of expression should not remain in doubt. "Whichever way [this Court] were to decide on the merits, it would be intolerable to leave unanswered, under these circumstances, an important question of freedom of the press under the First Amendment; an uneasy and unsettled constitutional posture of [the right of publicity] could only further harm the operation of a free press." *Miami Herald Publ'n Co. v. Tornillo*, 418 U.S. 241, 247, n.6 (1974).

So long as the decision below stands while the rest of the case slowly wends its way through the Missouri trial and appellate courts, the "predominant use" test will function as the de facto national standard for works of expression that evoke the name of a public figure. Creators and national distributors of motion pictures, novels, songs, comics and other works of artistic expression who ignore the Missouri test do so at their peril, and those who misconstrue the artistic tastes of a Missouri judge will pay a heavy price. Accordingly, many in the publishing and entertainment communities—out of reasonable caution or even excess cau-

tion—will censor their expression far beyond what the First Amendment requires.

For these reasons, exercise of jurisdiction in this case is not only "consistent with the pragmatic approach that [this Court has] followed in the past in determining finality," but essential to safeguard key First Amendment freedoms. *Cox Broad. Corp.*, 420 U.S. at 486.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

MICHAEL A. KAHN
Counsel of Record

GEOFFREY G. GERBER
BLACKWELL SANDERS
PEPER MARTIN LLP
720 Olive Street
Saint Louis, MO 63101
(314) 345-6496

CHARLES FRIED
1545 Massachusetts Ave.
Cambridge, MA 02138

EDWIN D. AKERS, JR.
GALLOP JOHNSON &
NEUMAN, L.C.
101 South Hanley Road,
Ste. 1600
Saint Louis, MO 63105

STUART BANNER
UCLA SCHOOL OF LAW
405 Hilgard Avenue
Los Angeles, CA 90095

APPENDIX

Appendix A

Supreme Court of Missouri
en banc.

JOHN DOE, a/k/a TONY TWIST, Appellant,

V.

TCI CABLEVISION, et al.,
Respondents.

No. SC84856.

APPEAL FROM THE CIRCUIT COURT
OF THE CITY OF ST. LOUIS

Appellant Anthony Twist, also known as Tony Twist, is a former professional hockey player in the National Hockey League. After learning of the existence of a comic book, titled *Spawn,* that contained a villainous character sharing his name, Twist brought misappropriation of name and defamation claims against respondents, the creators, publishers and marketers of *Spawn* and related promotional products. Respondents defended on First Amendment grounds. The circuit court dismissed the defamation count, but allowed the misappropriation of name count to go to trial, which resulted in a jury verdict in favor of Twist in the amount of $24,500,000. The circuit court, however, granted respondents' motion for judgment notwithstanding the verdict and, in the alternative, ordered a new trial in the event that its judgment notwithstanding the verdict was overturned on appeal. A request for injunctive relief was also denied. After appeal to the Court of

Appeals, Eastern District, this Court granted transfer. Mo. Const. art. V, sec. 10.

I.

Tony Twist began his NHL career in 1988 playing for the St. Louis Blues, later to be transferred to the Quebec Nordiques, only to return to St. Louis where he finished his career in 1999, due to injuries suffered in a motorcycle accident. During his hockey career, Twist became the League's preeminent "enforcer," a player whose chief responsibility was to protect goal scorers from physical assaults by opponents. In that role, Twist was notorious for his violent tactics on the ice. Describing Twist, a *Sports Illustrated* writer said: "It takes a special talent to stand on skates and beat someone senseless, and no one does it better than the St. Louis Blues left winger." Austin Murphy, *Fighting For A Living: St. Louis Blues Enforcer Tony Twist, Whose Pugilistic Talents Appear To Run In The Family, Doesn't Pull Any Punches On The Job,* SPORTS ILLUSTRATED, Mar. 16, 1998, at 42. The article goes on to quote Twist as saying, "I want to hurt them. I want to end the fight as soon as possible and I want the guy to remember it." *Id.*

Despite his well-deserved reputation as a tough-guy "enforcer," or perhaps because of that reputation, Twist was immensely popular with the hometown fans. He endorsed products, appeared on radio and television, hosted the "Tony Twist" television talk show for two years, and became actively involved with several children's charities. It is undisputed that Twist engaged in these activities to foster a positive image of himself in the community and to prepare for a career after hockey as a sports commentator and product endorser.

Respondent Todd McFarlane, an avowed hockey fan

and president of Todd McFarlane Productions, Inc. (TMP), created *Spawn* in 1992. TMP employs the writers, artists and creative staff responsible for production of the comic book. *Spawn* is marketed and distributed monthly by Image Comics, Inc., which was formed by McFarlane and others.

Spawn is "a dark and surreal fantasy" centered on a character named Al Simmons, a CIA assassin who was killed by the Mafia and descended to hell upon death. Simmons, having made a deal with the devil, was transformed into the creature Spawn and returned to earth to commit various violent and sexual acts on the devil's behalf. In 1993, a fictional character named "Anthony 'Tony Twist' Twistelli" was added to the *Spawn* storyline. The fictional "Tony Twist" is a Mafia don whose list of evil deeds includes multiple murders, abduction of children and sex with prostitutes. The fictional and real Tony Twist bear no physical resemblance to each other and, aside from the common nickname, are similar only in that each can be characterized as having an "enforcer" or tough-guy persona.

Each issue of the *Spawn* comic book contains a section entitled "Spawning Ground" in which fan letters are published and McFarlane responds to fan questions. In the September 1994 issue, McFarlane admitted that some of the *Spawn* characters were named after professional hockey players, including the "Tony Twist" character: "Antonio Twistelli, a/k/a Tony Twist, is actually the name of a hockey player of the Quebec Nordiques." And, again, in the November 1994 issue, McFarlane stated that the name of the fictional character was based on Twist, a real hockey player, and further promised the readers that they "will continue to see current and past hockey players' names in my books."

In April 1996, *Wizard,* a trade magazine for the comic book industry, interviewed McFarlane. In the published article, "Spawning Ground: A Look at the Real Life People Spawn Characters Are Based Upon," McFarlane is quoted as saying that he uses the names of real-life people to create the identities of the characters. Brief biographies and drawings of the *Spawn* characters follow the McFarlane interview. The paragraph devoted to the "Tony Twist" character contained a drawing of the character accompanied by the following description:

> First Appearance: Spawn # 6
>
> Real-Life Persona: Tony Twist.
>
> Relation: NHL St. Louis Blues right winger.
>
> The Mafia don that has made life exceedingly rough for Al Simmons and his loved ones, in addition to putting out an ill-advised contract on the Violator, is named for former Quebec Nordiques hockey player Tony Twist, now a renowned enforcer (i.e."Goon") for the St. Louis Blues of the National Hockey League.

Below the character description was a photo of a Tony Twist hockey trading card, in which Twist was pictured in his St. Louis Blues hockey jersey.

In 1997, Twist became aware of the existence of *Spawn* and of the comic book's use of his name for that of the villainous character. On one occasion, several young hockey fans approached Twist's mother with Spawn trading cards depicting the Mafia character "Tony Twist." Subsequently, at an autograph session Twist was asked to sign a copy of the *Wizard* article in which McFarlane was interviewed and Twist's hockey trading card was pictured.

In October 1997, Twist filed suit against McFarlane and various companies associated with the *Spawn* comic book (collectively "respondents"), seeking an injunction and damages for, *inter alia,* misappropriation of name and defamation, the latter claim being later dismissed. McFarlane and the other defendants filed motions for summary judgment asserting First Amendment protection from a prosecution of the misappropriation of name claim, but the motions were overruled.

At trial, McFarlane denied that the comic book character was "about" the real-life Tony Twist despite the fact that the names were the same. McFarlane also denied that he or the other defendants had attained any benefit by using Twist's name. Twist, however, presented evidence that McFarlane and the other defendants had indeed benefited by using his name. For example, Twist introduced evidence suggesting that in marketing Spawn products, McFarlane directly targeted hockey fans--Twist's primary fan base--by producing and licensing Spawn logo hockey pucks, hockey jerseys and toy zambonis. On crossexamination, McFarlane admitted that on one occasion defendants sponsored "Spawn Night" at a minor league hockey game, where McFarlane personally appeared and distributed Spawn products, including products containing the "Tony Twist" character. Another "Spawn Night" was planned to take place at a subsequent NHL game, but the event never occurred. On the issue of damages, Twist, through purported expert testimony, offered a formula for determining the fair market value that McFarlane and the other defendants should have paid Twist to use his name. In addition, Twist introduced evidence that his association with the *Spawn* character resulted in a diminution in the commercial value of his name as an endorser of products. To that end, Sean Philips, a former executive of a sports nutrition com-

pany, testified that his company withdrew a $100,000 offer to Twist to serve as the company's product endorser after Philips learned that Twist's name was associated with the evil Mafia don in the *Spawn* comic book.

As noted, at the conclusion of the trial, the jury returned a verdict in favor of Twist and against the defendants jointly in the amount of $24,500,000. On motions for a judgment notwithstanding the verdict or in the alternative a new trial, the circuit court overturned the verdict finding that Twist had failed to make a submissible case on the misappropriation of name count. The court further held that in the event the judgment notwithstanding the verdict was reversed on appeal, the motion for new trial was granted for evidentiary and instructional errors. Finally, the circuit court denied Twist's request for injunctive relief.

II.

The tort of misappropriation of name is one of four recognized torts falling under the general heading of invasion of privacy. *Sullivan v. Pulitzer Broadcasting Co.*, 709 S.W.2d 475, 477 (Mo. banc 1986). The interest protected by the misappropriation of name tort "is the interest of the individual in the exclusive use of his own identity, in so far as it is represented by his name or likeness, and in so far as the use may be of benefit to him or others." RESTATEMENT (SECOND) OF TORTS sec. 652C cmt. a (1977). Recently, development of the misappropriation of name tort has given rise to a separate yet similar tort termed the "right of publicity," which is said to "protect a person from losing the benefit of their [sic] work in creating a publicly recognizable persona." *Bear Foot, Inc. v. Chandler,* 965 S.W.2d 386, 389 (Mo.App.1998). Though facially similar, the protections afforded by each tort are slightly different: "the

[misappropriation of name tort] protects against intrusion upon an individual's private self-esteem and dignity, while the right of publicity protects against commercial loss caused by appropriation of an individual's [identity] for commercial exploitation." 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION sec. 28.6 (4th ed. 2003); *see also Bear Foot,* 965 S.W.2d at 389 ("In contrast to the [misappropriation of name tort], the right of publicity is not intended to protect the person's feelings....")

Because the two torts differ in the type of protection that each seeks to provide, there are corresponding differences between the types of damages that may be recovered. In a misappropriation of name action, a plaintiff may recover damages not only for pecuniary loss, but also for mental or emotional distress and suffering. *See Haith v. Model Cities Health Corp. of Kansas City,* 704 S.W.2d 684, 688 (Mo.App.1986); RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 49 cmt. b (1995); MCCARTHY, TRADEMARKS sec. 28.6 (explaining that in misappropriation of name actions, damages are "measured by 'mental distress'--some bruising of the human psyche.") By contrast, in a right of publicity action, "the measure of damages properly focuses on the pecuniary loss to the plaintiff or the unjust pecuniary gain to the defendant." RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 49 cmt. b; *see also Bear Foot,* 965 S.W.2d at 389; *Haith,* 704 S.W.2d at 688.

In this case, Twist seeks to recover the amount of the fair market value that respondents should have paid to use his name in connection with Spawn products and for damage done to the commercial--value in effect the endorsement value--of his name. Therefore, Twist's case, though brought as a misappropriation of name action, is more precisely labeled a right of publicity

action--a point that both parties appear to concede in their briefs.

Despite the differences in the types of damages that may be recovered, the elements of the two torts are essentially the same. To establish the misappropriation tort, the plaintiff must prove that the defendant used the plaintiff's name without consent to obtain some advantage. *Nemani v. St. Louis Univ.*, 33 S.W.3d 184, 185 (Mo. banc 2000); *Haith,* 704 S.W.2d at 687. In a right of publicity action, the plaintiff must prove the same elements as in a misappropriation suit, with the minor exception that the plaintiff must prove that the defendant used the name to obtain a *commercial* advantage. RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 46; *see also* RESTATEMENT (SECOND) OF TORTS sec. 652C cmt. b (explaining that, in contrast, the misappropriation of name tort applies when plaintiff's name is used for commercial *or* non-commercial advantage). Given the similarity of elements of the two actions, Missouri cases analyzing the tort of misappropriation of name are pertinent to our recognition of a right of publicity claim.

In *Nemani,* the plaintiff, a research professor, brought suit against St. Louis University after the university used plaintiff's name in support of a federal grant application. This Court, reviewing the claim as a misappropriation of name tort, held that a defendant is liable under the tort when it uses a plaintiff's name without consent to obtain an advantage. 33 S.W.3d at 185. However, this Court was careful to point out that "[n]ot all uses of another's name are tortious":

> It is the plaintiff's name *as a symbol of [his] identity* that is involved here, and not [his name] as a mere name. Name appropriation occurs where a defendant makes use of the name to pirate the plaintiff's

identity for some advantage.

Id. (Citations omitted.) (Emphasis added.) *See also Haith,* 704 S.W.2d 684; *Munden v. Harris,* 153 Mo.App. 652,134 S.W. 1076 (1911).

In addition, though *Nemani* did not expressly so hold, an element of intent is implicit in the requirement that the identity be used to obtain an advantage. In a right of publicity case, plaintiff must prove that defendant intended to obtain a commercial advantage, and it is not enough to show that defendant incidentally obtained a commercial advantage by using plaintiff's name or that defendant had some other purpose in using plaintiff's name other than to obtain a commercial advantage. *Wendt v. Host Int'l, Inc.,* 125 F.3d 806, 811 (9th Cir.1997); *Benavidez v. Anheuser Busch, Inc.,* 873 F.2d 102, 104 (5th Cir.1989); *Henley v. Dillard Dept. Stores,* 46 F.Supp.2d 587, 596 (N.D.Tex.1999); *see generally* RESTATEMENT (SECOND) OF TORTS sec. 652C cmt. d (explaining that a misappropriation of name or likeness claim stands only if the name or likeness was used "for the purpose of appropriating to the defendant's benefit the commercial or other values associated with the name of likeness").

To summarize, in view of *Nemani* and the earlier precedent of *Bear Foot,* and consistent with the RESTATEMENT (THIRD) OF UNFAIR COMPETITION, the elements of a right of publicity action include: (1) That defendant used plaintiff's name as a symbol of his identity (2) without consent (3) and with the intent to obtain a commercial advantage.

In this case, the circuit court's entry of JNOV was based on a finding that Twist failed to make a submissible case on the commercial advantage element. In addition, and though the court implicitly held

otherwise, respondents claim that the grant of JNOV also was justified because Twist failed to prove that his name was used as "symbol of his identity."

"Generally, in determining whether a plaintiff made a submissible case, the evidence is considered in the light most favorable to the plaintiff, giving him all reasonable beneficial inferences." *Emery v. Wal-Mart Stores, Inc.*, 976 S.W.2d 439, 443 (Mo. banc 1998). It is "only where there is a complete absence of probative fact to support the jury's conclusion" that this Court will decide that a submissible case was not made. *Giddens v. Kansas City Southern Ry.* Co., 29 S.W.3d 813, 818 (Mo. banc 2000).

A.

Respondents' initial contention that Twist did not prove that his name was used as a "symbol of his identity" is spurious. To establish that a defendant used a plaintiff's name as a symbol of his identity, "the name used by the defendant must be understood by the audience as referring to the plaintiff." RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 46 cmt. d; *see also* J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY sec. 4.48 (2d ed.2000) (quoting *Geisler v. Petrocelli,* 616 F.2d 636, 639 (2d Cir.1980)) (stating that the defendant's use of the name must be " 'something more than [an] amusing coincidence' "). In resolving this issue, the fact-finder may consider evidence including "the nature and extent of the identifying characteristics used by the defendant, the defendant's intent, the fame of the plaintiff, evidence of actual identification made by third persons, and surveys or other evidence indicating the perceptions of the audience." RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 46 cmt. d.

Here, all parties agree that the "Tony Twist" charac-

ter is not "about" him, in that the character does not physically resemble Twist nor does the *Spawn* story line attempt to track Twist's real life. Instead, Twist maintains that the sharing of the same (and most unusual) name and the common persona of a tough-guy "enforcer" create an unmistakable correlation between Twist the hockey player and Twist the Mafia don that, when coupled with Twist's fame as a NHL star, conclusively establishes that respondents used his name and identity. This Court agrees. Indeed, respondent McFarlane appears to have conceded the point by informing his readers in separate issues of *Spawn* and in the *Wizard* article that the hockey player Tony Twist was the basis for the comic book character's name.

Arguably, without these concessions, some *Spawn* readers may not have made the connection between Twist and his fictional counterpart. However, other evidence at trial clearly demonstrated that, at some point, *Spawn's* readers did in fact make the connection, for both Twist and his mother were approached by young hockey fans under the belief that appellant was somehow affiliated with the *Spawn* character. On this record, respondents cannot seriously maintain that a good many purchasers of *Spawn* did not readily understand that respondents' use of the name referred to appellant. Accordingly, this Court holds that Twist presented sufficient evidence to prove that his name was used as a symbol of his identity.

B.

As noted, the grant of JNOV was based on the commercial advantage element of the cause of action. Specifically, the court held that the record was devoid of credible evidence that respondents intended (1) "to injure Twist's marketability," (2) "to capitalize on the market recognition of the name," or (3) "derived any

pecuniary benefit whatsoever from the use of that name."

At the outset, two of the premises for the circuit court's rationale are incorrect: Twist was under no obligation to prove that respondents intended to injure Twist's marketability or that respondents actually derived a pecuniary benefit from the use of his name. As explained, the commercial advantage element of the right of publicity focuses on the defendant's intent or purpose to obtain a commercial benefit from use of the plaintiff's identity. But in meeting the commercial advantage element, it is irrelevant whether defendant intended to injure the plaintiff, McCarthy, Rights of Publicity sec. 3.28, or actually succeeded in obtaining a commercial advantage from using plaintiff's name, *see Brown v. Ames,* 201 F.3d 654, 661- 62 (5th Cir.2000); *Henley,* 46 F.Supp.2d at 597; McCarthy, Rights of Publicity sec. 3.2. That said, it still was incumbent upon Twist to prove that respondents used his name intending to obtain a commercial advantage.

Twist contends, and this Court again agrees, that the evidence admitted at trial was sufficient to establish respondents' intent to gain a commercial advantage by using Twist's name to attract consumer attention to *Spawn* comic books and related products. As the Ninth Circuit noted in *Abdul-Jabbar v. General Motors Corp.,* 85 F.3d 407, 416 (9th Cir.1996), "The first step toward selling a product or service is to attract the consumers' attention." (Citation omitted.) *See also id.* at 415 (holding that to the extent that defendant's use of plaintiff's name attracted consumers' attention to its product, defendant gained a commercial advantage); *Henley,* 46 F.Supp.2d at 597 (holding that the commercial advantage or benefit element is shown if by using plaintiff's name or likeness in the product defendant sought "to

catch the eye of the consumer and make the [product] more interesting"); RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 47 cmt. c. At a minimum, respondents' statements and actions reveal their intent to create the impression that Twist was somehow associated with the *Spawn* comic book, and this alone is sufficient to establish the commercial advantage element in a right of publicity action. *See Abdul-Jabbar,* 85 F.3d at 414-16; *Carson v. Here's Johnny Portable Toilets, Inc.,* 698 F.2d 831, 835-36 (6th Cir.1983) (holding that defendants violated plaintiff Johnny Carson's right of publicity when it used the phrase, "Here's Johnny," in its advertisement); *Henley,* 46 F.Supp.2d at 592-93 (holding in right of publicity case that defendant's use of the words, "Don's Henley," in advertisement was intended to elicit an association with plaintiff Don Henley).

But this is not all. At trial, Twist introduced evidence that respondents marketed their products directly to hockey fans. For example, respondents produced and distributed Spawn hockey jerseys and pucks and sponsored a "Spawn Night" at a minor league hockey game where other Spawn products were distributed, including products featuring the character "Tony Twist." Additionally, Twist points to McFarlane's statement in the November 1994 issue of *Spawn,* in which he promised readers that "they will continue to see current and past hockey players' names in [his] books." This statement, Twist correctly contends, amounts to an inducement to *Spawn* readers, especially those who are also hockey fans, to continue to purchase the comic book in order to see the name Tony Twist and other hockey players. This is evidence from which the jury could infer that respondents used his name to obtain a commercial advantage.

In support of the court's ruling that the evidence

presented was insufficient to show that Twist's name was used to obtain a commercial advantage, respondents cite *Nemani, Haith, and Munden* to demonstrate the kind of commercial advantage that must be shown and to highlight that Twist's evidence was dissimilar. In *Nemani* and *Haith,* the defendants used the plaintiffs' names in grant applications for money; in *Munden,* the defendant used a picture of the plaintiff in an advertisement. Though it is true that respondents' intent to obtain a commercial advantage is not as obvious as that found in *Nemani, Haith,* and *Munden,* the fact remains that to the extent that the evidence suggests that respondents used Twist's name to attract attention to their product, they did so to obtain a commercial advantage. Therefore, this Court holds that Twist presented sufficient evidence to establish that respondents used his name for a commercial advantage.

III.

Having determined that Twist made a submissible case at trial, we next address whether the right of publicity claim is nevertheless prohibited by the First Amendment. Courts throughout the country have struggled with this issue. Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface,* 23 LOY. L.A. ENT. L.REV. 471, 488-98 (2003). Of course, not all speech is protected under the First Amendment, and in cases like this, courts often will weigh the state's interest in protecting a plaintiff's property right to the commercial value of his or her name and identity against the defendant's right to free speech.

Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977) is the first and only right of publicity case decided by the

Supreme Court. The case involved the unauthorized broadcast of a videotape of the plaintiff's 15-second "human cannonball" act during a nightly news program. The plaintiff brought suit under the state-recognized tort of right of publicity, alleging that the unauthorized broadcast amounted to an "unlawful appropriation" of his "professional property," and the defendant broadcasting company defended on First Amendment grounds. In balancing the respective parties' interests, the Court held, "Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent." *Zacchini,* 433 U.S. at 574-75, 97 S.Ct. 2849. Because the *Zacchini* Court limited its holding to the particular facts of the case--the appropriation of plaintiff's "entire act"--it does not control the case at hand. Nonetheless, there are larger lessons that are certainly applicable.

First, the Court acknowledged, as had many lower courts previously, that the right of publicity is not always trumped by the right of free speech. Explaining the competing right of publicity interests, the Court observed that "[t]he rationale for protecting the right of publicity is the straightforward one of preventing unjust enrichment by the theft of goodwill. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay." *Id.* at 576, 97 S.Ct. 2849.

Second, the Court distinguished claims for right of publicity or name appropriateness from claims for defamation like those adjudicated in *New York Times v. Sullivan,* 376 U.S. 254, 84 S.Ct. 710, 11 L.Ed.2d 686

(1964), and *Hustler Magazine v. Falwell,* 485 U.S. 46, 108 S.Ct. 876, 99 L.Ed.2d 41 (1988), and claims for "publicity that places plaintiff in a 'false light' "like that adjudicated in *Time, Inc. v. Hill,* 385 U.S. 374, 87 S.Ct. 534, 17 L.Ed.2d 456 (1967). Because property interests are involved in the former categories but not the latter, *Zacchini,* 433 U.S. at 573, 97 S.Ct. 2849, the Court refused to apply the *New York Times v. Sullivan* "actual malice" standard that speech is privileged unless it was "knowingly false or was published with reckless disregard for the truth." *Id.* at 571, 97 S.Ct. 2849, *et seq.* As the Court later made clear in *Hustler, Zacchini* stands for the proposition that "the 'actual malice' standard does not apply to the tort of appropriation of a right of publicity... ." 485 U.S. at 52, 108 S.Ct. 876.

Right to publicity cases, both before and after *Zacchini,* focus instead on the threshold legal question of whether the use of a person's name and identity is "expressive," in which case it is fully protected, or "commercial," in which case it is generally not protected. For instance, the use of a person's identity in news, entertainment, and creative works for the purpose of communicating information or expressive ideas about that person is protected "expressive" speech. *See, e.g., Hoffman v. Capital Cities/ABC, Inc.,* 255 F.3d 1180, 1185 (9th Cir.2001); *Cardtoons v. Major League Baseball Players Ass'n,* 95 F.3d 959, 969-70 (10th Cir.1996); *Rogers v. Grimaldi, MGM/UA,* 875 F.2d 994, 1003-05 (2nd Cir.1989). On the other hand, the use of a person's identity for purely commercial purposes, like advertising goods or services or the use of a person's name or likeness on merchandise, is rarely protected. *See, e.g., Downing v. Abercrombie & Fitch,* 265 F.3d 994, 1002 (9th Cir.2001); *White v. Samsung Elec. Am., Inc.,* 971 F.2d 1395, 1397-99 (9th Cir.1992); *Midler v. Ford Motor* Co., 849 F.2d 460,462-64 (9th Cir.1988).

Several approaches have been offered to distinguish between expressive speech and commercial speech. The RESTATEMENT, for example, employs a "relatedness" test that protects the use of another person's name or identity in a work that is "related to" that person. The catalogue of "related" uses includes "the use of a person's name or likeness in news reporting, whether in newspapers, magazines, or broadcast news... use in entertainment and other creative works, including both fiction and nonfiction... use as part of an article published in a fan magazine or in a feature story broadcast on an entertainment program... dissemination of an unauthorized print or broadcast biography, [and use] of another's identity in a novel, play, or motion picture... ." RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 47 cmt. c at 549. The proviso to that list, however, is that "if the name or likeness is used solely to attract attention to a work that is *not related* to the identified person, the user may be subject to liability for a use of the other's identity in advertising... ." *Id.* (Emphasis added.)

California courts use a different approach, called the "transformative test," that was most recently invoked in *Winter v. D.C. Comics,* 30 Cal.4th 881, 134 Cal.Rptr.2d 634, 69 P.3d 473 (2003), a case with a remarkably similar fact situation. In that case, Johnny and Edgar Winters, well-known musicians with albino complexions and long white hair, brought a right of publicity action against defendant D.C. Comics for its publication of a comic book featuring the characters "Johnny and Edgar Autumn," half-worm, half-human creatures with pale faces and long white hair. On appeal, the California Supreme Court considered whether the action was barred by the First Amendment and employed " 'what is essentially a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements

so as to be transformed into something more than a mere celebrity likeness or imitation.'" *Id.* at 475 (citing *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797, 799 (2001)). Concluding that the comic book characters "Johnny and Edgar Autumn" "are not just conventional depictions of plaintiffs but contain significant expressive content other than plaintiffs' mere likenesses," *id.* at 479, the Court held that the characters were sufficiently transformed so as to entitle the comic book to full First Amendment protection.

The weakness of the RESTATEMENT'S "relatedness" test and California's "transformative" test is that they give too little consideration to the fact that many uses of a person's name and identity have both expressive and commercial components. These tests operate to preclude a cause of action whenever the use of the name and identity is in any way expressive, regardless of its commercial exploitation. Under the relatedness test, use of a person's name and identity is actionable only when the use is solely commercial and is otherwise unrelated to that person. Under the transformative test, the transformation or fictionalized characterization of a person's celebrity status is not actionable even if its sole purpose is the commercial use of that person's name and identity. Though these tests purport to balance the prospective interests involved, there is no balancing at all--once the use is determined to be expressive, it is protected. At least one commentator, however, has advocated the use of a more balanced balancing test--a sort of predominant use test--that better addresses the cases where speech is both expressive and commercial:

> If a product is being sold that predominantly exploits the commercial value of an individual's iden-

> tity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some "expressive" content in it that might qualify as "speech" in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.

Lee, *supra,* at 500.

The relative merit of these several tests can be seen when applied to the unusual circumstances of the case at hand. As discussed, Twist made a submissible case that respondents' use of his name and identity was for a commercial advantage. Nonetheless, there is still an expressive component in the use of his name and identity as a metaphorical reference to tough-guy "enforcers." And yet, respondents agree (perhaps to avoid a defamation claim) that the use was not a parody or other expressive comment or a fictionalized account of the real Twist. As such, the metaphorical reference to Twist, though a literary device, has very little literary value compared to its commercial value. On the record here, the use and identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.

IV.

The circuit court held that in the event that its grant of JNOV was determined to be in error on appeal, as previously held, respondents' alternative motion for a new trial was granted on several grounds. One such dispositive ground is instructional error in the verdict director given for the misappropriation of name count.

The verdict director for this claim, which was the same for each defendant, read:

> Your verdict must be for plaintiff and against defendant Todd McFarlane if you believe:
>
> First, defendant Todd McFarlane intentionally used or published plaintiff's name, and
>
> Second, defendant Todd McFarlane derived advantage from the use or publication of plaintiffs name, or plaintiff suffered harm as a result of defendant Todd McFarlane's use of publication of plaintiffs name, and
>
> Third, plaintiff did not consent to the use of publication, and
>
> Fourth, as a direct result thereof, plaintiff sustained damage.

In deciding whether the given verdict director was erroneous, it is helpful to again list the elements of the tort of right of publicity: (1) The defendant used plaintiff's name as a symbol of his identity (2) without consent (3) and with the intent to obtain a commercial advantage. Notably, the verdict director omitted any requirement that the jury find that defendant used plaintiff's identity rather than merely his name. This omission, however, did not prejudice respondents, as the evidence at trial so clearly established that appellant Tony Twist was the basis for the *Spawn* character's name.

However, a second and ultimately fatal flaw lies in the verdict director's failure to properly instruct the jury on the commercial advantage element of the tort. By requiring that the jury find only that respondents "derived advantage from the use or publication of plaintiffs name," as opposed to a finding that respondents used plaintiff's name "with the intent to derive" or "for

the purpose of deriving" an advantage, the jury was allowed to render a verdict that could have been based on the mere incidental result of the use rather than the intentional result. Here, this seemingly fine distinction could well have borne different results. Although the evidence supported a finding that respondents used Twist's name and identity "with the intent to obtain a commercial advantage," alternatively, the jury could have found that respondents had no intent to obtain a commercial advantage--that there was a different purpose for using the name--and to the extent that some advantage was obtained, it was merely incidental. In fact, respondent McFarlane so testified in his defense, adding that the real reasons he used Twist's name were

> one, it's a pretty cool name, and, two, it's easy to remember, it's an easy thing--cause I create a lot of characters, you need sort of easy ways to remember names... . And again, ...[with] Twist, you always sort of have a Twist ending. You just sort of come up with stuff that sort of, you know, semi- clever, if you will.

Because the verdict director allowed the jury to render a verdict for plaintiff without a finding that respondents *intended* to obtain a commercial advantage, and because the jury may well have determined that respondents obtained a commercial advantage even though they did not intend to do so, the verdict must be set aside.

V.

In addition to the misappropriation of name claim, Twist sought equitable relief from the circuit court in the form of a permanent injunction prohibiting respondents from using his "name, commercial image, persona, autograph and/or likeness *for any purpose* with-

out his consent." (Emphasis added.) The court denied equitable relief concluding, *inter alia,* that the injunction sought was overbroad because it could "interfere with legitimate and proper action by the defendants in the future." This Court holds that the circuit court was correct in doing so, because, as respondents state in their brief, the requested injunction attempted to prohibit respondents "from engaging in a variety of expressive activities unrelated to the subject matter of this lawsuit and undoubtedly protected by the First Amendment--*e.g.,* a parody of plaintiff, a commentary on his fighting style, a factual report on this lawsuit."

VI.

For the foregoing reasons, the circuit court's judgment notwithstanding the verdict is reversed, the judgment granting a new trial is affirmed, the judgment denying injunctive relief is affirmed, and the case is remanded.

s/_____
Stephen N. Limbaugh, Jr., Judge

All concur.

Appendix B

In the Missouri Court of Appeals
Eastern District
Division Five

JOHN DOE, a.k.a. TONY TWIST,
Appellant,

V.

TCI CABLEVISION, ET. AL.
Respondent.

No. ED78785

Appeal from the Circuit Court of the City of St. Louis

Hon. Robert H. Dierker

FILED: July 23, 2002

The plaintiff, Anthony R. Twist, also known as Tony Twist, is a retired professional hockey player. He complains that the defendants[1] misappropriated his name by using it for a comic book villain without his consent and identifying him as the source of the name for the character. He also complains that the defendants "cross-marketed" action figure toys derived from other comic book characters by packaging the comic books with the toys and holding a promotional "*Spawn* Night" at a

[1] The remaining defendants, Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc. Todd McFarlane Entertainment, Inc. and Image Comics will be referred to throughout this opinion as the McFarlane defendants.

minor league hockey game. Twist brought suit, seeking damages for the past use of his name and an injunction barring further use. From their first responsive pleading the McFarlane defendants claimed the protection of the First Amendment of the United States Constitution. The trial court, applying the First Amendment of the United States Constitution. The trial court, applying the First Amendment, dismissed the defamation count, but found the First Amendment not applicable to the misappropriation of name claim and submitted that claim to the jury. The jury returned a verdict for the plaintiff in the amount of $24,500,000. The trial court then granted the defendants' motion for judgment notwithstanding the verdict, finding that the plaintiff failed to present evidence that defendants possessed a specific intent to use Twist's name for their benefit or to his detriment. In the alternative, the trial court granted defendants' motion for a new trial because of numerous instructional and evidentiary errors. The request for injunctive relief was denied. We find the First Amendment defense applicable to the misappropriation claim. Accordingly, that claim is not submissible because it does not comply with the "of and concerning" requirement of the First Amendment. We affirm.

FACTS

During his playing years, Tony Twist was regarded as one of the most violent "enforcers" in hockey and attained a national reputation for violence on the ice hockey rink.[2] Like many professional athletes, he hoped to exploit his sports star status to become a broadcaster

[2] The role of an "enforcer" in hockey is to protect goal scorers from physical assaults by opponents. Describing Twist, a *Sports Illustrated* article said: "It takes a special talent to stand on skates and

Continued on Next Page

and a celebrity promoter of products. To this end, he received coaching, appeared on television and radio programs and for two years hosted "The Tony Twist Show" on a local television station. He also presented evidence that he had a good reputation off the ice for his work with children's charities.

Todd McFarlane is a comic book writer. In 1992, McFarlane, with others, formed Image Comics, Inc. to solicit, market, print and distribute comics. He also created his own comic book, *Spawn,* and formed Todd McFarlane Productions, Inc., to oversee the writers, artists and creative staff involved in its production.

Spawn is a dark and surreal fantasy revolving around a character named Al Simmons, a CIA assassin murdered by his corrupt partners at the CIA. Simmons' soul goes to Hell, makes a deal with the Devil and returns to earth as "Spawn," a creature with superhuman powers. Spawn struggles to break his pact with the devil, but is placed under the influence of a guardian demon who uses Spawn's weaknesses to get him to do the Devil's bidding.

Spawn became a successful comic book from its first issue. McFarlane parlayed this success into comic book spin-offs: an animated series, a feature-length movie, a line of toys based on *Spawn* characters, a line of clothes bearing the *Spawn* logo and various other items.

Footnote 2 Continued

beat someone senseless, and no one does it better than the St. Louis Blues left winger." The article goes on to quote Twist to say "I want to hurt them. I want to end the fight as soon as possible and I want the guy to remember it." Austin Murphy, *Fighting For A Living: St. Louis Blues Enforcer Tony Twist, Whose Pugilistic Talents Appear To Run In The Family, Doesn't Pull Any Punches On The Job*, SPORTS ILLUSTRATED, Mar. 16, 1998, at 42, available at 1998 WL 8979450.

In November of 1993, McFarlane unveiled a fictional Mafioso character named "Tony Twist" who, as the monthly episodes develop, becomes an antagonist of the Spawn character. This fictional Tony Twist commits and orders murders, child abductions and a variety of other illegal and immoral deeds. Besides bearing the same name as the plaintiff, the only resemblance the plaintiff claims between the fictional Tony Twist and himself is metaphorical in that both are "enforcers," one in the world of professional hockey and the other in the fictional world of *Spawn.* [3]

In September and November of 1994, responding to fan letters in the back of the comic book, McFarlane identified the plaintiff as the source of the name for the fictional mafia character. The September letter, in relevant part, says:

> The great thing about writing and drawing your own book is you get to have as much fun with it as you want. ...Whenever I choose a name I try to have a little bit of play on it... I am a big hockey fan, and a lot of my characters have been named after current NHL hockey players. For example, Antonio Twistelli, a/k/a Tony Twist, is actually the name of a hockey player of the Quebec Nordiques.

In April 1996, *Wizard,* a trade magazine for the comic book industry, highlighted McFarlane's method of naming characters and published an article titled: *"Spawning Ground: A Look At The Real Life People Spawn Characters Are Based Upon."*[4] In that article the author says:

---

[3]The Twist character appears 166 times in 31,000 panels, approximately one-half of one percent of the total panels.

[4]*Wizard* settled with the plaintiff prior to verdict and is not a party to this appeal.

Having trouble coming up with character names? Use the Todd McFarlane Method.

McFarlane uses the names of his family and friends when it comes to the character identities inside his comic book *Spawn*.

"It's easier to come up with the names of people sitting next to you," the writer/artist explains. "And for the most part, if I don't put my friends and family in my books, I guarantee that nobody at Marvel is going to do it for me. I do it just because I can. I've got that freedom. It's one of the great things about controlling your own book."

Named for loved ones, friends, colleagues and employees at Todd McFarlane Productions, a few of the characters appearing in *Spawn* feature similarities to their real-life counterparts. Many others appropriate only the name, sometimes being introduced and dispatched in the same issue.

This is followed by brief biographies and drawings of the characters, along with photos of the real persons they are named after. The section devoted to the Tony Twist character shows a picture of the fictional comic book character and a photo of a Tony Twist hockey trading card. It is captioned "ANTHONY 'TONY TWIST' TWISTELLI," and states:

First Appearance: *Spawn #6*

Real-Life Persona: Tony Twist.

Relation: NHL St. Louis Blues right winger.

The Mafia don that has made life exceedingly rough for Al Simmons and his loved ones, in addition to putting out an ill-advised contract on the Violator, is named for former Quebec Nordiques hockey player Tony Twist, now a renowned en-

forcer (i.e. "Goon") for the St. Louis Blues of the National Hockey League."

On October 31, 1997, Twist filed suit against the McFarlane defendants and many others[5] seeking damages and an injunction for, among other things, defamation and misappropriation of name. The McFarlane defendants filed their answer containing a number of denials and defenses, among them their fourth affirmative defense, which reads: none of the contents, characters, story lines or descriptions contained in the Spawn comic books... is identifiable with plaintiff or purport to be *"of and concerning"* the plaintiff but are purely fictional fantasies and no reasonable person could confuse the Plaintiff with the fictional fantasies and characters portrayed therein. (emphasis ours)

This fourth affirmative defense, carried forward into the McFarlane defendants' motion to dismiss resulted in the trial court's dismissal of the defamation claim because no "person of ordinary intelligence would understand Defendants' publication to convey factual assertions 'of and concerning' Plaintiff." But the court, without reference to the "of and concerning" require-

[5]Plaintiff's second amended petition listed the following defendants: TCI Cablevision of Missouri, Inc., Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc. (d/b/a/ McFarlane Toys, TMP Apparel, Todd Toys, TMP Entertainment, TMP Cards, TMP Toys, McFarlane Design Group, McFarlane Entertainment, TMP Ventures, and McFarlane Toys Collector's Club), Image Comics, Inc., Gareb Shamus Enterprises, Inc. (d/b/a/ Wizard Press, Inc.), Titan Books & Comics, Inc., Grupo Editorial, Inc., Time Warner Entertainment Company, L.P., Home Box Office, Inc., Blockbuster Entertainment, Inc., Hollywood Entertainment Corp. (d/b/a/ Hollywood Video), Video Update, Inc., Diamond Comic Distributors, Inc., Legends, Comics & Cards, Inc., and any and all unknown persons, corporations, limited liability companies, partnerships, or other entities of any other named defendant.

ment of the First Amendment, denied the motion to dismiss the misappropriation action, finding only that "Plaintiff's petition explicitly pleads the elements of a wrongful appropriation claim."[6]

McFarlane and related entities then filed their motions for summary judgment, arguing, among other things, that the First Amendment protected them from Twist's claim for misappropriation of name. Twist's response to the motion did not dispute that *Spawn* is a work of fiction and that he is a public figure. The trial court nevertheless denied the motions, finding that the First Amendment did not protect McFarlane from a misappropriation of name action. In its order denying the defendants' motion for summary judgment, the court declared what evidence was necessary to make the case and that the First Amendment was not a bar. That order reads:

> If Plaintiff can demonstrate, as a matter of fact, both that Defendants knowingly utilized his name and likeness for the purpose of advancing their economic interests, and also that in fact Defendants derived economic benefit (in the form of increased sales of their products) from that use, or in fact caused Plaintiff direct pecuniary loss (by damaging his ability to market his name or image), then Defendants may be liable notwithstanding the First Amendment.

---

[6]The trial court dismissed Twist's claims against the following defendants because they were mere "passive distributors" of the comic books and related items: TCI Cablevision of Missouri, Inc., Titan Books & Comics, Inc., Grupo Editorial, Inc., Home Box Office, Inc., Blockbuster Entertainment, Inc., Hollywood Entertainment Corp., Video Update, Inc., Legends, Comics & Cards, Inc.,

At trial there was no dispute that McFarlane used Twist's name. The evidence viewed in a light most favorable to the verdict establishes that the plaintiff did serve as an inspiration for the comic book character. McFarlane denies, however, that the comic book character "appropriates the identity" of or makes statements that a reasonable reader would conclude are "about" Twist, the hockey player. He also denies any benefit came to him from the use of Twist's name.

To prove that the association with the Tony Twist character diminished his value as an endorser of products, Twist emphasized the violent and sexual nature of the comic book character. Twist also offered testimony from a former executive of a sports nutrition company that in 1999 he was going to offer Twist a $100,000 contract to endorse sports nutrition products, but changed his mind after he learned of Twist's association with the comic book.

To prove that the McFarlane defendants benefited, Twist called two experts who gave their opinion as to the fair market value of the Twist name. Brian Till opined that the fair market value of the use of Twist's name in the comics was equal to 15% of the combined gross revenues of all *Spawn*-related products in which the Twist character appears, plus 9% of the gross revenues of all other *Spawn*-related products. Rocky Arcenaux opined that the use of Twist's name was worth 20% of the combined gross revenues of all *Spawn*-related products, 15% for the use of the name plus an additional 5% because of the expected negative impact on Twist's future endorsements caused by his association with *Spawn*. Finally, Twist offered testimony from financial expert Jay Barrington that the gross revenues from *Spawn*-related sales for all defendants combined was $122,708,261.

The case went to the jury on the misappropriation of name count. The instruction submitting that count required the jury to find only that the defendants intentionally used or published Twist's name, without his consent, and that either the defendants benefited or Twist was damaged by that use. The verdict director read:

> Your verdict must be for plaintiff and against defendant Todd McFarlane if you believe:
>
> First, defendant Todd McFarlane intentionally used or published plaintiff's name, and
>
> Second, defendant Todd McFarlane derived advantage from the use or publication of plaintiff's name, or plaintiff suffered harm as a result of defendant Todd McFarlane's use of publication of plaintiff's name, and
>
> Third, plaintiff did not consent to the use of publication, and
>
> Fourth, as a direct result thereof, plaintiff sustained damage.[7]

The jury returned a verdict for Twist and jointly against all remaining defendants in the amount of $24,500,000, slightly under 20% of the defendants' combined gross revenues from the time *Spawn* was first published.

The defendants then moved for judgment notwithstanding the verdict or in the alternative for a new trial. In its order sustaining that motion the trial court found it had improperly submitted the misappropriation of name count to the jury. In particular, it found error in its failure to require the jury to find that the defendants possessed a "specific intent" to injure Twist or benefit

---

[7]The verdict directors were the same for every defendant; only the name of the defendant changed.

themselves from the use of his name. Accordingly, the court granted the motion for judgment notwithstanding the verdict, ruling that Twist failed to make a submissible case on his claim for misappropriation of name because there was no "substantial evidence of a specific intent by defendants to use his name for their benefit or to [Twist's] detriment." The trial court further ruled in the alternative that if the judgment notwithstanding the verdict is reversed on appeal, the motion for new trial would be granted because of instructional errors and the erroneous admission of Twist's expert testimony. Finally, the request for injunctive relief was denied.

Twist raises three points on appeal. First, he argues that the trial court erred by changing the elements of the misappropriation of name claim after trial to include a requirement of specific intent to harm or benefit. Twist maintains that there is no such requirement for a misappropriation of name and, alternatively, if there is such a requirement, that he presented substantial evidence of the McFarlane defendants' intent to benefit from the use of his name. Second, he claims that the testimony submitted through his experts was admissible and that the verdict director and damage instruction properly submitted the elements of Twist's damages.[8] Finally, Twist argues that, absent his consent, the further use of his name by the defendants should be enjoined.

---

[8]Instruction No. 16, the damage instruction, submitted to the jury read as follows: "If you find in favor of plaintiff, then you must award plaintiff such sum as you believe will fairly and justly compensate plaintiff for any damages you believe he sustained and is reasonably certain to sustain in the future as a direct result of the defendants' use or publication of his name."

STANDARD OF REVIEW

When reviewing the grant of a motion for judgment notwithstanding the verdict we must determine if the plaintiff made a submissible case. *Jungerman v. City of Raytown,* 925 S.W.2d 202, 204 (Mo. banc 1996). We must affirm a trial court's ruling, though the reason given for it may be erroneous, if it is sustainable for any reason. *Graue v. Missouri Property Ins. Placement Facility,* 847 S.W.2d 779, 782 (Mo. banc 1993).

Generally, we view the evidence in a light most favorable to the plaintiff, giving him the benefit of all reasonable inferences and disregarding all unfavorable evidence and inferences. *Id.* However, cases raising First Amendment issues reqüire an independent examination of the whole record to insure that the judgment does not constitute a forbidden intrusion upon the field of free expression. *Bose Corp. v. Consumers Union of United States, Inc.,* 466 U.S. 485, 499-501 (1984). A properly preserved First Amendment defense "raising questions of constitutional fact compel[s] this court's *de novo* review." *Id.* In that pursuit, we strictly scrutinize state imposed content-based restrictions on speech to insure that they promote a compelling government interest and are narrowly tailored to further that interest. *Sable Communications of Cal., Inc. v. FCC,* 492 U.S. 115,126 (1989).

TWIST'S CAUSE OF ACTION

The law has protected a person's interest in his good name for more than a thousand years L. ELDRIDGE, THE LAW OF DEFAMATION § 53, at 293-294 (1978). A cause of action for defamation, whether by libel or slander, serves to insulate the individual from false and unwarranted statements harmful to that person's reputation. RESTATEMENT (SECOND) TORTS §§ 580A, 580B (1977).

Over the last century the law has expanded the protection a person's name and identity is entitled to receive against unauthorized commercial exploitation.

In 1946 Congress passed the Lanham Act, providing a federal cause of action and remedy for the unauthorized use of a person's identity that "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities. ..." 15 U.S.C. § 1125(a)(1)(A) (2002).

Law review articles creating the foundation for the misappropriation of name and right of publicity torts date as far back as 1890.[9] But the first case to formally distinguish these claims from those that protect the right of privacy was written in 1953. *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), cert. denied 346 U.S. 816 (1953). That case and its antecedents make clear that the torts of "misappropriation of name" and "right of publicity" protect persons against the unauthorized commercial use of their identity.

The elements of these torts are essentially the same. *See* RESTATEMENT (SECOND) TORTS § 652C (describing the misappropriation tort); RESTATEMENT (THIRD) UNFAIR COMPETITION § 46 (1995)(describing the right of publicity). Both require the use of the plaintiff's identity for some commercial purpose without the plaintiff's consent. They differ only in their justifications and the type of damages awarded. *See* MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 5:61 (2d ed. 2000). In a misappropriation of name case the damages are based on the

---

[9]*See* Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 196 (1890).

mental distress caused by an invasion of personal privacy. *Id.* In a right of publicity case, damages are measured by the fair market value the advertiser would have had to pay to use that person's identity in a commercial and any dilution of the commercial value of the identity caused by excessive or harmful uses. *See* RESTATEMENT (THIRD) UNFAIR COMPETITION § 49 cmt. d.

Twist brings his case under the banner of "misappropriation of name," but we find his tort more properly labeled a "right of publicity" claim because he seeks to recover the damage to his endorsement value and a proportionate share of the revenue generated by the use of his identity. His theory throughout the trial was that he has exclusive control over the use of his name. Twist cites three Missouri cases for the proposition that taking a person's identity for a purely commercial purpose is prohibited by Missouri law. In *Munden v. Harris*, 134 S.W. 1076 (Mo. App. 1911), a jeweler published an advertisement containing the picture of a five-year-old next to a caption that invites the reader to buy jewelry. *Id.* at 1077. The child's parents sued the advertiser for invasion of privacy for publishing his picture in an advertisement without his consent. *Id.* The Court of Appeals held that "one has an exclusive right to his picture, on the score of its being a property right of material profit." *Id.* at 1079. The court then allowed the plaintiff to go forward to show both damages to his reputation and feelings, as well as for any value that the defendant derived from the unauthorized use of the child's identity in advertising its goods. *Id.* at 1079, 1081.

Twist also cites *Haith v. Model Cities Health Corp. of Kansas City,* 704 S.W.2d 684 (Mo.App. W.D. 1986) and *Nemani v. St. Louis University,* 33 S.W.3d 184 (Mo. banc 2000). In both of these cases medical research

facilities were accused of using the plaintiffs' names without consent on applications for federal grants. 704 S.W.2d at 687; 33 S.W.3d at 185. In *Haith,* the Western District concluded that proof of these allegations was sufficient to submit the case to a jury because the plaintiff's name was taken in pursuit of an economic benefit for the defendant without plaintiff's permission. 704 S.W.2d at 687-88. *Nemani* embraces the same general principles, but the Missouri Supreme Court resolved the case on the facts, concluding that the plaintiff consented to the use of his name. 33 S.W.3d at 186.

Contrary to Twist's argument, *Munden, Haith,* and *Nemani* do not stand for the proposition that a public figure possesses an exclusive right to control the use of their name. *Munden* involved only the use of the plaintiff's picture, not his name. *Munden,* 134 SW. at 1077. *Haith* and *Nemani* involve the use of the plaintiffs' names, but both cases make clear that liability cannot rest on *mere* use of a person's name. In *Haith,* the court said: "it is the plaintiff's name as a symbol of... identity that is involved here, and not... as a mere name." 704 S.W.2d at 687. The *Nemani* court held similarly, saying: "Name appropriation occurs where a defendant makes use of the name *to pirate the plaintiff's identity* for some advantage." 33 S.W.3d at 185 (emphasis added)(internal quotation omitted). The plaintiff correctly identifies these cases as standing for the bare proposition that a publisher cannot use a person's identity to advance a purely commercial purpose.

Munden, Haith and *Nemani* are distinguishable from the present case, however, because they involve neither a public figure nor a work of fiction. Twist cites no case that allows a public figure, celebrity or sports figure to recover on a "misappropriation of name" or "right of

publicity" theory simply because a fiction writer names a character after them. Every court to address this issue has concluded that name-sameness alone does not give rise to a claim under either of these torts.[10] The same reasoning underlies the law's refusal to allow a person to copyright his name. *See* 17 U.S.C. § 102; *Downing v. Abercrombie & Fitch,* 265 F.3d 994, 1003-1004 (9th Cir. 2001).

Twist's theory is, however, more subtle. He argues that the use of his name for a fictional "enforcer," coupled with the identification of him as the inspiration for the character, effectively appropriated his identity. Cases in other jurisdictions make clear that even subtle appropriations of aspects of a celebrity's identity may be actionable if taken for a purely commercial purpose.

---

[10] *See, e.g., Nebb v. Bell Syndicate*, 41 F. Supp 929 (DC NY 1941)(Privacy claim under New York statute dismissed where the only similarity between the plaintiffs and the defendant's syndicated comic strip characters "Mr. and Mrs. Rudy Nebb" was the name); *Costanza v. Seinfeld*, 279 A.D.2d 255 (NY App. 2001)(court properly dismissed misappropriation case brought by Costanza against comedian Jerry Seinfeld based upon use of same last name); *T. J. Hooker v. Columbia Pictures Indus.*, 551 F. Supp. 1060 (ND Ill. 1982)(no right of publicity or Lanham Act violation for coincidental use of the name of woodcarver T. J. Hooker as the name of a character and title of TV series "T. J. Hooker"); *DeClemente v. Columbia Pictures Indus., Inc.*, 860 F. Supp. 30 (E.D.N.Y. 1994)(plaintiff karate teacher known locally as the "Karate Kid" could not prove violation of right of publicity claim for use of the name of "Karate Kid" for a character and a title of movie); *Newton v. Thomason*, 22 F.3d 1455 (9th Cir. 1994)(affirming summary judgment where singer Wood Newton alleged that his name was appropriated for a character in the television show "Evening Shade"); *Allen v. Gordon*, 446 N.Y.S.2d 48 (N.Y. App. Div. 1982)(Dr. Allen could not prove misappropriation based on name-sameness of fictional psychiatrist because name-sameness is insufficient to prove the book was "of and concerning" the plaintiff).

In "commercial speech" the message is "buy." MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 8:17. The Supreme Court has defined commercial speech as "speech that *proposes* a commercial transaction." *Board of Trustees of the State Univ. of N.Y. v. Fox,* 492 U.S. 469, 482 (1989)(emphasis in original).

In *Carson v. Here's Johnny Portable Toilets, Inc.,* the defendant used only the expression "Here's Johnny" to market its toilets. 698 F.2d 831, 837 (6thCir. 1983). "Here's Johnny" was Carson's signature introduction at the beginning of his popular television show and was widely recognized as a reference to the plaintiff Johnny Carson. *Id.* at 832-33. Finding that Carson stated a claim upon which relief could be granted, the court held, "a celebrity's legal right of publicity is invaded whenever his identity is intentionally appropriated for a commercial purpose." *Id.* at 837. In *Midler v. Ford Motor Co.,* Ford Motor Company used a "sound alike" to record a popular Bette Midler song for a commercial. 849 F.2d 460, 461 (9th Cir. 1988). The Ninth Circuit held that "when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort . . .." *Id.* at 463. These cases teach that using identity markers to falsely suggest a relationship between a person and product may constitute a violation of the plaintiff's right of publicity.

Munden, Haith, and *Nemani* correctly illustrate the mechanics of a private citizen's cause of action for misappropriation of name. *Carson* and *Midler,* on the other hand, illustrate the protection the law affords celebrities seeking to protect their property interest in their identity. In all of these cases aspects of the plaintiffs' identities were used in an effort to bring

economic gain to the defendants without the consent or economic participation of the plaintiff.

Twist understandably seeks to bring his claim within this stream of cases. But the factual distinctions between Twist's case and these cases are glaring. In both the misappropriation of name and the right of publicity cases, the defendants used the plaintiffs' identities to aid a purely commercial transaction. *Haith* and *Nemani* were applications to win federal grants for their institutions. *Munden, Carson* and *Midler* were advertisements for jewelry, toilets and cars.

Here, the alleged use of Twist's identity appears in a comic book with significant republication of the stories in the television and video mediums. Twist does not contest that a plain reading of the comic book confirms it as a work of fiction. Because he seeks to restrict the ability of the McFarlane defendants to use his identity and name in a work of fiction, he implicates the First Amendment, requiring us to strictly scrutinize his efforts to control the product of the defendants' creative processes. We must, therefore, apply First Amendment principles to determine if *Spawn,* in any medium, is protected speech.

APPLICATION OF THE FIRST AMENDMENT TO THE RIGHT OF PUBLICITY AND MISAPPROPRIATION OF NAME TORTS

The First Amendment to the United States Constitution says: "Congress shall make no law... abridging the freedom of speech, or of the press..." While originally applicable only to the federal government, the Equal Protection Clause of the Fourteenth Amendment protects freedom of speech and the press against abridgement by state action. *Gitlow v. New York,* 268 U.S. 652, 666 (1925). A state violates Fourteenth Amendment

rights when it creates a rule of law authorizing a judgment against a person for exercising his First Amendment rights. *New York Times v. Sullivan,* 376 U.S. 254 (1964).

When a celebrity such as Twist invokes the courts to seek payment for certain speech he characterizes as "unauthorized" and to enjoin further speech, there is clearly "state action" triggering First Amendment scrutiny. Twist asks the state to compel payment for the alleged misappropriation of his identity and an injunction banning all speech using his identity in fiction, except on terms he alone dictates. This is a content-based restriction on speech.

Content-based restrictions limit speech based on the message conveyed. They offend the First Amendment on several grounds. First, content-based restrictions distort public debate by preventing messages from being expressed and heard, impeding the search for truth. *See Abrams v. United States,* 250 U.S. 616, 630 (1919) (Holmes, J., dissenting) (in the long run, the best test of truth is "the power of the thought to get itself accepted in the competition of the market"). Second, content-based restrictions obstruct meaningful participation in self-government. *See First National Bank of Boston v. Bellotti,* 435 U.S. 765, 791 (1978) (in a self-governing nation, the people, not the government, "are entrusted with the responsibility for judging and evaluating the relative merits of conflicting arguments"). Third, content-based restrictions frustrate individual self-fulfillment. *See Whitney v. California,* 274 U.S. 357, 375 (1927) (Brandeis, J., concurring) (in our constitutional system, the protection of free expression is designed to enhance personal growth, self-realization, and the development of individual autonomy). Content-based restrictions on speech are disfavored be-

cause they are in essence a manifestation of government's distrust of the individual's ability to decide for themselves the type of information or entertainment they wish to view or hear.

Content-based restrictions can, therefore, stand only if they pass strict scrutiny. *Sable Communications of Cal., Inc. v. FCC,* 492 U.S. 115, 126 (1989). In applying strict scrutiny to any state action that proposes to restrict the content of speech, we must determine if the state action protects a compelling government interest. If so, we then determine if the restriction is narrowly tailored to further that interest. *Id.*

The "compelling government interest" that Twist seeks to advance is the state's interest in protecting his property right in his persona and its endorsement value. Citing *Zacchini v. Scripps-Howard Broadcasting Co.,* 433 U.S. 562 (1977), Twist argues that the First Amendment does not apply to a property-based tort such as the right of publicity. In *Zacchini* a local television station aired a performer's 15-second "human cannonball" act on the evening news without his consent. *Id.* at 564. The Supreme Court held that the First Amendment did not protect the television station from Zacchini's right of publicity claim because the television station aired Zacchini's *"entire act." Id.* at 578-79. The *Zacchini* court said:

> the State's interest in permitting a "right of publicity" is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment. As we later note, the State's interest is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation.

Id. at 574-75 (citations omitted).

Twist would have us conclude from this that the First Amendment never applies to a right of publicity claim. But the Supreme Court drew a clear distinction between what was appropriated from Zacchini and what is taken in the usual "right of publicity" or "misappropriation of name" case, saying:

> the broadcast of petitioner's entire performance, *unlike the unauthorized use of another's name for purposes of trade or the incidental use of a name or picture by the press,* goes to the heart of petitioner's ability to earn a living as an entertainer.

Id. at 576 (emphasis added). The *Zacchini* Court was not concerned with the use of another's name or identity, but "the appropriation of the very activity by which the entertainer acquired his reputation in the first place." *Id.* The Tenth Circuit has more accurately, we think, described *Zacchini* as a "red herring," reading it not as a right of publicity case at all, but rather a "right of performance" case. *Cardtoons, L.C. v. Major League Baseball Players Association,* 95 F. 3d 959, 973 (10th Cir. 1996). We believe, like the Tenth Circuit, that *Zacchini* was written with the express purpose of allowing a performer to derive a benefit from his own performance without interference from the First Amendment. *Id.*

Subsequent Supreme Court treatment of *Zacchini* confirms the very specific nature of its holding. *See San Francisco Arts & Athletics, Inc. v. United States Olympic Committee,* 483 U.S 522, 532-33 (1987)(reading *Zacchini* to provide protection only when the very expression being complained of is the product of the plaintiff's "own talents and energy, the end result of much time, effort, and expense"); *Harper & Row, Pub-*

lishers, Inc. v. Nation Enterprises, 471 U.S. 539, 556-57 (1985)(interpreting *Zacchini as* a protection of copyright and citing it for the proposition that "copyright assures those who write and publish factual narratives... may at least enjoy the right to market *the original expression* contained therein as just compensation for their investment." (emphasis added)); *Cohen v. Cowles Media Co.,* 501 U.S. 663, 669 (1991)(citing *Zacchini* for the proposition that "[t]he press, like others interested in publishing, may not publish copyrighted material without obeying the copyright laws.").

Zacchini does not carve out a wholesale exception to the First Amendment for right of publicity or misappropriation of name claims. It simply stands as an affirmative protection designed to vindicate the right of a performer to derive a benefit from his own performance. *See* MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 8:27. Because we disagree with Twist's reading of *Zacchini,* we conclude that the First Amendment must be applied to his claim that *Spawn,* an undisputed work of fiction, violates his right of publicity.

THE FIRST AMENDMENT AND WORKS OF FICTION

Twist insists that *Spawn* is a product and nothing more and, as such, is not entitled to First Amendment protection. Twist does not allege that his performance was taken, but that his name was misappropriated in pursuit of commercial gain. We must therefore determine if a public figure's property interest in his identity as represented by his name can survive a First Amendment defense raised by a publisher who names a character in a work of fiction after that public figure. To make such a determination we must balance the competing interests. *Konigsberg v. State Bar of California,* 366 U.S. 36, 49-51 (1961). When balancing a state's

interest in protecting reputation and property against the First Amendment the scales are heavily weighted in favor of freedom of speech. This is because, as Justice Cardozo has said, the First Amendment represents "a different plane of social and moral values" without which "neither liberty nor justice would exist...." *Palko v. Connecticut,* 302 U.S. 319, 326-27 (1937) (finding that freedom of thought and speech are "the matrix, the indispensable condition, of nearly every other form of freedom.").

Speech need not be "political" to be protected by the First Amendment. *United Mine Workers v. Illinois Slate Bar Ass'n*, 389 U.S. 217, 223 (1967). "The First Amendment was fashioned to assure unfettered interchange of ideas for the bringing about of political *and social changes* desired by the people." *Connick v. Myers,* 461 U.S. 138, 145 (1983) (emphasis added). In the words of Justice Thurgood Marshall:

> The First Amendment serves not only the needs of the polity but also those of the human spirit - a spirit that demands self-expression. Such expression is an integral part of the development of ideas and a sense of human identity. To suppress expression is to reject the basic human desire for recognition and affront the individual's worth and dignity.

Procunier v. Martinez, 416 U.S. 396, 427 (1974).

In defense of this free, open and creative self-expression, the First Amendment protects speech in any medium that either informs or entertains. *Winters v. New York,* 333 U.S. 507, 510 (1948). This includes books, motion pictures, radio, television programs, live entertainment, poetry, painting, music, dramatic works, comics and commercials. *See National Endowment for the Arts v. Finley* 524 U.S. 569, 602 (1998); *Hustler*

Magazine v. Falwell, 485 U.S. 46 (1988); *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of N. Y.*, 447 U.S. 557 (1980). Even obscenity is protected if it has "serious literary, artistic, political, or scientific value." *Miller v. California*, 413 U.S. 15, 26 (1973).

People have been describing, defining and commenting on the world around them through two-dimensional art since the beginning of human civilization. Comic books are a recent extension of this form of self-expression. Often controversial, they have been described as "the mass-market, pulp-paper bad boys of publishing." John M. McGuire, *Laughing Matters?*, ST. LOUIS POST-DISPATCH at 1E, January 18, 1990. First appearing in 1911, by the end of the 1930's comic books were a popular form of entertainment.[11] But with their popularity, came virulent criticism. *Id.* Described as violent, "injected with sex," and even an avenue of communistic ideas, by the late 1940's they were being banned all across America and even publicly burned. TIME MAGAZINE, Dec. 20,1948; Bill Smith, *Comic book code dying a slow death*, ST. LOUIS POST-DISPATCH , July 16, 1993.

In the 1955 Senate Subcommittee Report, *Comic Books and Juvenile Delinquency*, the crime and horror comic books of the era were described as "short courses in murder, mayhem, robbery, rape, cannibalism, carnage, necrophilia, sex, sadism, masochism, and virtually every other form of crime, degeneracy, bestiality, and horror." *Comic Books and Juvenile Delinquency, Interim Report of the Committee on the Judiciary*, 84th Congress, 1st Session, S. Rep. No. 62 at 9 (1955). Despite this, the Subcommittee rejected any resort to governmental censorship as "totally out of keeping with

---

[11] Kevin W. Saunders, *Media Self-Regulation of Depictions of Violence: A Last Opportunity*, 47 OKLA. L. Rev. 445, 448 (1994).

our basic American concepts of a free press operating in a free land for a free people." *Id.* at 23.

Comic books continue to be a legitimate and important part of the American artistic and literary landscape. Their combination of pictures and words often help young readers to learn. Their characters and imagery form a powerful subtext to American culture and imagination and for that reason are the bases of many Hollywood movies. Though often criticized as "low brow" or "literature for the illiterate," nothing prevents this art form from rising to the most sublime levels, as in Art Spiegelman's *Maus*, a stunning comic book version of the Holocaust, which won the Pulitzer Prize in 1992.

We therefore conclude that the comic book is an important expressive medium entitled to the full protections of the First Amendment.

Another, and even less likely, medium of expression that has also found First Amendment protection is the parody baseball card. In *Cardtoons* the Tenth Circuit held that they too are protected because they entertain and provide social commentary on the wealth of professional athletes, an issue of contemporary interest. 95 F.3d at 962 & 976.

We are informed by the *Cardtoons* court's balancing of the interests that protect both the right of publicity and the First Amendment. Identifying several justifications for protecting a celebrity's proprietary interest in their identity that court observed:

> The right is thought to further economic goals such as stimulating athletic and artistic achievement, promoting the efficient allocation of resources, and protecting consumers. In addition, the right of publicity is said to protect various noneconomic

> interests, such as safeguarding natural rights, securing the fruits of celebrity labors, preventing unjust enrichment, and averting emotional harm.

Id. at 973. The *Cardtoons* court did not find these interests compelling, however, when balanced against First Amendment principles. The court rejected the argument that the right of publicity provides athletes an incentive to perform because, unlike a performer such as Zacchini, the commercial value of a sports star's identity is a by-product of their performance, not their performance itself. *Id.* The court also rejected the unjust enrichment argument, concluding that it has little application when the use of the celebrity's identity is not in an advertisement. *Id.* at 975.

An interesting distinction between *Cardtoons* and the present case is that in the former the subject of parody was fully developed by the parties. Here, McFarlane does not claim in his testimony or argument that the Twist character in *Spawn* is a parody or any other kind of literary comment on Twist or violence in sports.[12] Nor does Twist claim the character is a parody of himself. Still, the cases are similar in that they involve the use of sports stars' names, and the products invoke or "call up" the identities of those stars in the minds of those who purchase them. Insofar as readers might view the use of Twist's name for the Mafia "enforcer" as a comment on Twist, the cases are on a par.

The ability to use Twist's name for a Mafioso character in *Spawn*, like the ability to make parody baseball cards, is important in a society such as ours, where so

[12] McFarlane does, however, attribute a motive to Twist for avoiding the issue of parody, claiming that he does so to avoid the holdings in *Falwell v. Hustler* and *N.Y. Times v. Sullivan,* discussed infra.

much of social life and discourse revolves around celebrities. One commentator has described celebrities as "common points of reference for millions of individuals who may never interact with one another, but who share, by virtue of their participation in a mediated culture, a common experience and a collective memory."[13] Another says that celebrities are "the chief agents of moral change in the United States."[14] The California Supreme Court, expounding on this in their recent decision in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, emphasized that the importance of being able to speak freely about and creatively use celebrities' identities:

> Entertainment and sports celebrities are the leading players in our Public Drama. We tell tales, both tall and cautionary, about them. We monitor their comings and goings, their missteps and heartbreaks. We copy their mannerisms, their styles and their modes of conversation and consumption. Whether or not celebrities are 'the chief agents of moral change in the United States' they certainly are widely used -- far more than are institutionally anchored elites -- to symbolize individual aspirations, group identities, and cultural values. Their images are thus important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation.

21 P.3d 797, 803 (Cal. 2001).

---

[13] JOHN B. THOMPSON, IDEOLOGY AND MODERN CULTURE: CRITICAL SOCIAL THEORY IN THE ERA OF MASS COMMUNICATION 163 (1990).

[14] RICHARD SCHICKEL, INTIMATE STRANGERS: THE CULTURE OF CELEBRITY 29 (1985).

To extend the right of publicity to allow a celebrity to control the use of his or her identity in a work of fiction would grant them power to suppress ideas associated with that identity, placing off-limits a useful and expressive tool. This, in turn, would effectively revoke the poetic license of those engaged in the creative process. To proscribe their right to use certain names, words, thoughts and ideas would ultimately apply to the rest of us, impeding our ability to express ourselves.[15]

In a line of cases, from *New York Times v. Sullivan,* 376 U.S. 254 (1964) to *Hustler Magazine v. Falwell,* 485 U.S. 46 (1988), the Supreme Court held that speech about "public officials" and "public figures" is so important that it is protected unless the plaintiff can prove by "clear and convincing evidence" that the defendant published the statements with "actual malice," knowledge that the statements are false or in reckless disregard of their truth. 376 U.S. at 279-280; 388 U.S. at 155. This protection has been found regardless of the name the public official or public figure gives to his cause of action.

In *New York Times* and *Curtis Publishing Co. v. Butts*, 388 U.S. 130 (1967), the plaintiffs alleged libel. In *Time, Inc. v. Hill,* 385 U.S. 374, 388 (1967) the plaintiff filed suit under the New York "privacy" or "misappropriation of name" statute. In *Hustler* the plaintiff sued for intentional infliction of emotional distress. In each case the Court unequivocally ruled that the plaintiff must prove by "clear and convincing evidence" that the defendant published statements "of and concerning" the plaintiff with knowledge that the statements are false or in reckless disregard of their truth. *New York Times,* 376 U.S. at 279-280; *Curtis*

---

[15] *See* Madow. *Private Ownership of Public Image: Popular Culture and Publicity Rights,* 81 CAL. L. Rev. 125, 138 (1993).

Publishing Co, 388 U.S. at 155; *Time,* 385 U.S. at 388; *Hustler,* 485 U.S. at 56.

Hustler is particularly instructive because, as in this case, it involved a cartoon. There, *Hustler Magazine,* which features glossy nude photos of women in compromising positions, featured a cartoon about Jerry Falwell, an evangelical minister and the leader of a political-religious group known as the Moral Majority. In his opinion for a unanimous Court, Chief Justice Rehnquist recited the facts in that case as follows:

> The inside front cover of the November 1983 issue of Hustler Magazine featured a "parody" of an advertisement for Campari Liqueur that contained the name and picture of respondent and was entitled "Jerry Falwell talks about his first time." This parody was modeled after actual Campari ads that included interviews with various celebrities about their "first times." Although it was apparent by the end of each interview that this meant the first time they sampled Campari, the ads clearly played on the sexual double entendre of the general subject of "first times." Copying the form and layout of these Campari ads, Hustler's editors chose respondent as the featured celebrity and drafted an alleged "interview" with him in which he states that his "first time" was during a drunken incestuous rendezvous with his mother in an outhouse. The Hustler parody portrays respondent and his mother as drunk and immoral, and suggests that respondent is a hypocrite who preaches only when he is drunk. *Hustler*, 485 U.S. at 48.

Falwell filed suit for invasion of privacy, defamation and intentional infliction of emotional distress. *Id.* at 47-48. The trial court directed a verdict on the invasion of privacy count on the ground that Falwell was a public

figure, but submitted the other two claims to a jury. *Id.* at 48. Though the jury found in favor of the defendants on the defamation count, it awarded Falwell $100,000 in compensatory and $100,000 in punitive damages on the emotional distress claim. *Id.* at 49. The Fourth Circuit Court of Appeals affirmed. *Id.* The Supreme Court reversed.

Characterizing the *Hustler* cartoon as a mere "distant cousin" of the honored political cartoons of the past, the court found that it was nonetheless fully protected by the First Amendment because there is no "principled standard to separate the one from the other... ." *Id.* at 55. The Court held:

> We conclude that public figures and public officials may not recover for the tort of intentional infliction of emotional distress by reason of publications such as the one here at issue without showing in addition that the publication contains a false statement of fact which was made with "actual malice," i.e., with knowledge that the statement was false or with reckless disregard as to whether or not it was true.

Id. at 56. Because the jury found the *Hustler* cartoon could not be understood as describing actual facts about Falwell, the Supreme Court reversed, holding the judgment entered against Hustler inconsistent with the First Amendment. *Id.*

Twist points out that *Hustler* was an emotional distress claim, not a "right of publicity" or "misappropriation of name" claim. But the difference in the torts does not affect the protection afforded by the Constitution. A person cannot be defamed by or suffer emotional distress from a publication unless his identity is appropriated. In every case where a public figure raises a

defamation or emotional distress claim against a publisher he can also bring a "misappropriation of name" or "right of publicity" claim. If Falwell, Twist or other public figures were permitted to prevail on a "right of publicity" or "misappropriation of name" without satisfying the *New York Times* test, our First Amendment protections would be an illusion. Every public figure, under the guise of "misappropriation" or "right of publicity," could circumvent the First Amendment and prevent all speech about them that they do not like. This is clearly not the law. [16]

As a work of fiction, *Spawn* is fully protected by the First Amendment. It does not lose that protection because it is published for profit. *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council,* 425 U.S. 748, 762 (1976). Before Twist can recover on his right of publicity claim he must, therefore, satisfy the *New York Times* "actual malice" standard, knowledge that the statements are false or in reckless disregard of their truth. Prerequisite to satisfying this "actual malice" standard is that the publication be "of and concerning" the plaintiff. *See, e.g.,* McCarthy, *supra* at 8-108; *Hicks v. Casablanca Records,* 464 F. Supp. 426, 432 (U.S. Dist. N.Y. 1978). It is not enough that the publication invokes the plaintiff's identity or is in some sense "about" the plaintiff. A reader must reasonably

---

[16] It is true that in *Hustler* the Supreme Court said that *Zacchini* stands for the proposition that "the 'actual malice' standard does not apply to the tort of appropriation of a right of publicity..." *Hustler*, 485 U.S. at 52. But that statement must be read in context. The "right of publicity" the *Zacchini* court addressed was the appropriation of a performer's "entire act," not the use of his name or persona in a work of fiction. The *New York Times* test cannot be applied when what is appropriated is a person's "entire act" because it is logically impossible for an accurate rebroadcast of an entire performance to be false.

believe that the depiction is meant to portray, "in actual fact, the plaintiff *acting as described.*" *Bindrim* V. *Mitchell,* 92 Cal. App. 3d 61, 78, cert. denied, 444 U.S. 984 (1979) (emphasis added).

The application of the "of and concerning" requirement to a fictional publication is a threshold question. Here, the trial court applied that requirement when dismissing the plaintiff's defamation claim, finding no reasonable person could believe that the events portrayed in *Spawn* are "of and concerning" the plaintiff. But the court refused to apply the First Amendment, including that requirement, when addressing the misappropriation claim, finding only that "Plaintiff's petition explicitly pleads the elements of a wrongful appropriation claim."

The court again reached the "of and concerning" issue when the McFarlane defendants sought summary judgment on the misappropriation claim. But, when addressing the misappropriation claim, it found the degree of similarity between the plaintiff and defendant's comic book character to be a question of fact and, for that reason, denied the motion for summary judgment on that claim. Finding the First Amendment inapplicable, the court essentially adopted Twist's reading of *Zacchini.* It is this ruling that made necessary a trial on the "merits" on the misappropriation claim.

After trial, the court granted the judgment notwithstanding the verdict, continuing to ignore the "of and concerning" requirement and the applicability of the First Amendment. The court reasoned instead that the Missouri misappropriation tort requires a specific intent to benefit the defendant or to harm the plaintiff and because no such proof was offered the motion for judgment notwithstanding the verdict must be granted. While we reject the trial court's reasoning for granting

the motion for JNOV, we will affirm it if it is sustainable for any reason.

We therefore treat the "of and concerning" requirement of the First Amendment before treatment of any alleged defects in the submission of a state tort claim. Accordingly, we must determine if a reasonable reading of *Spawn* can lead to the conclusion that the Twist comic book character is meant to portray, in actual fact, Twist the hockey player acting as described.

Twist's entire argument focuses on avoiding such an application because of his familiarity with the depiction of the Tony Twist character in *Spawn*. Even the most cursory examination of the comic book reveals that no intelligent person could believe that the fictional Tony Twist's actions are those of the plaintiff. First, *Spawn* is a comic book about a man who has come back from the dead with superhuman powers. The character bearing the plaintiff's name has an entirely different history and bears no physical resemblance to the plaintiff. Even the plaintiff admits that no one could believe that the actions of the fictional Tony Twist are his actions. We conclude that a reader could not reasonably believe that the Twist comic book character is meant to portray, in actual fact, Twist the hockey player, acting as described. Accordingly, and consistent with the decisions reached in similar cases in other jurisdictions,[17] we find that *Spawn* is not "of and con-

[17] *See e.g., Food Lion, Inc. v. Capital Cities/ABC, Inc.*, 194 F.3d 505, 522-24 (4th Cir. 1999)(First Amendment precludes award of publication damages for non-reputational tort claims unless plaintiff satisfies the proof standard of *New York Times*); *Meeropol Nizer*, 560 F.2d 1061, 1066 (2nd Cir. 1977)("The same standards of constitutional protection apply to an invasion of privacy as to libel claims"); *Matthews v. Wozencraft*, 15 F.3d 432, 439 (5th Cir. 1994)("Courts long ago recognized that a celebrity's right of

Continued on Next Page

cerning" the plaintiff, and he cannot therefore maintain his claim for either misappropriation of name or violation of his right of publicity.[18]

The First Amendment Protects McFarlane's Truthful Identification Of Twist As The Inspiration For A Fictional Character

Having held the use of Twist's identity in a work of fiction is protected by the First Amendment, we next treat Twist's theory that he can recover because McFarlane identified him as the inspiration for the fictional character. He is identified as that inspiration

---

Footnote 17 Continued

publicity does not preclude others from incorporating a person's name, features or biography in a literary work, motion picture, news or entertainment story."); *Ruffin-Steinback v. Depasse,* 82 F. Supp. 2d 723 (E.D. Mich. 2000) (appropriation of names and likenesses of singing group in TV "docu-drama" non-actionable); *Seale v. Gramercy Pictures,* 949 F. Supp. 331, 335 (E.D. Pa. 1996) later proceedings at 964 F. Supp. 918, 923 (E.D. Pa. 1997) *aff'd* 156 F.3d 1225 (3rd Cir. 1998) (dismissing right of publicity, privacy and false endorsement claims of former Black Panther leader Bobby Seale for use of his name and image in a movie, accompanying book, home video and sound track CD); *Polydoros v. Twentieth Century Fox Film Corp.,* 67 Cal.Rptr. 2d 305, 307-08 (Cal.App. 1997)(fictionalized motion picture which used the plaintiff's name and childhood identity was privileged under the First Amendment); *Rosemont Enterprises, Inc. v. McGraw-Hill Book Co.,* 380 N.Y.S.2d 839, 844 (1975) ("it should go without saying that a person need not get the consent of a celebrity to write a fictional piece about that person, so long as it is made clear that the creative work is fictional.").

[18] *See Milkovich v. Lorain Journal Co.,* 497 U.S. 1, 20 (1990)("the *Bresler-Letter Carriers-Falwell* line of cases provides protection for statements that cannot 'reasonably [be] interpreted as stating actual facts' about an individual. This provides assurance that public debate will not suffer for lack of 'imaginative expression' or the 'rhetorical hyperbole' which has traditionally added much to the discourse of our Nation.")

both in the back of the comic book and in McFarlane's interview in the *Wizard* publication. Twist alleges that this identification constitutes a commercial exploitation of his fame to sell more comic books.

Twist correctly concludes that, if his name and identity are used in an advertisement to encourage a reader to buy the comic book, he is entitled to his share of profits from that sale. We must therefore determine if Twist's name as a symbol of his identity was used to persuade readers to buy a copy of the comic book. In that pursuit we must determine if the content of McFarlane's responses to the fan letters and his interview with *Wizard* invoke Tony Twist's identity and propose a commercial transaction.

In his September letter McFarlane says:

> The great thing about writing and drawing your own book is you get to have as much fun with it as you want... Whenever I choose a name I try to have a little bit of play on it... I am a big hockey fan, and a lot of my characters have been named after current NHL hockey players. For example, Antonio Twistelli, a/k/a Tony Twist, is actually the name of a hockey player of the Quebec Nordiques.

In his interview with *Wizard* he is reported to have said:

> It's easier to come up with the names of people sitting next to you.... And for the most part, if I don't put my friends and family in my books, I guarantee that nobody at Marvel is going to do it for me. I do it just because I can. I've got that freedom. It's one of the great things about controlling your own book.

As can be seen, neither in McFarlane's responses to the fan mail nor in his *Wizard* interview does he request that the readers purchase anything or propose any other commercial transaction. In order to characterize them as "advertising," we would have to adopt the view that all speech that contributes to sales is, in the end, merely commercial speech. But under such a standard even core political speech in newspapers would be commercial because the paper's reporting and commentary contribute to sales. No reasonable reading of the fan mail responses could lead to a conclusion that McFarlane is proposing a commercial transaction. He is simply expressing his opinion and relating information that a reader of his comic books might find interesting.

The fan mail section of the comic book is "news" to *Spawn's* readers. While some may not find that type of news to be very important in the scheme of things, it is not for them to judge, but for you and every individual reader. First Amendment principles require us to be extremely cautious of declaring any information unnewsworthy and outside the protections of the First Amendment. *Harper & Row Publishers,* 471 U.S. at 561.

That caution has led courts to find the following "newsworthy" and protected from assertions of privacy and publicity rights: the latest fashions, tips on grooming, the latest romantic exploits of celebrities, places to find nude beaches, who is the favorite member of a rock group, what movies are being shown, who is in them, and more. *See* McCarthy, *supra,* § 8:52 (citing cases).

McFarlane's statements, both in the back of *Spawn* and in his interview with the writer from *Wizard,* were truthful statements about a matter of legitimate public interest; namely, how a comic book writer names his

characters. It would be strange indeed were the law to allow McFarlane to name his characters after celebrities, and then prevent him from admitting this. *See Smith v. Daily Mail Publishing Co.*, 443 U.S. 97, 103 (1979) (State officials may not constitutionally punish publication of protected information absent a need to further a state interest of the highest order.). McFarlane's public admission that Twist was the inspiration for his fictional mafia character Tony Twist is, therefore, protected by the First Amendment.

The First Amendment And Cross-Marketing Protected Works Of Fiction With Other Purely Commercial Enterprises

Twist's final complaint is that McFarlane cross-marketed the comic book by packaging it with action figures and holding a "*Spawn* Night" at a minor league hockey game, arguing that this proves that McFarlane targeted hockey fans and thus used Twist's popularity to boost sales.

The trial record reveals, however, that McFarlane packaged two *Spawn* action figures (Overt-Kill and Tremor) with a shortened version of a *Spawn* comic book. No toy resembling the Twist comic book character or the plaintiff was ever made. In both comics contained in the promotional packages the Tony Twist character appeared on only one page inside each comic book. Neither the Twist character nor the name "Tony Twist" appeared on the package.

Twist fails to direct us to any evidence that his name or identity was used either in marketing the toys or at the promotional *Spawn* night. Even if the appearance of the fictional Twist character inside the comics would qualify as an "incidental use" of Twist's name, it is nonetheless protected by the First Amendment. *See*

Ruffin-Steinback v. Depasse, 267 F.3d 457, 462 (6th Cir. 2001) (holding that "the use of plaintiffs' fictionalized likenesses in a work protected by the First Amendment and the advertising [sic] incidental to such uses did not give rise to a claim for relief under the plaintiffs' rights of publicity"); *Guglielmi,* 603 P.2d at 462, (Bird, C.J., concurring) ("Since the use of [Rudolph] Valentino's name and likeness in the film was not an actionable infringement of Valentino's right of publicity, the use of his identity in advertisements for the film is similarly not actionable."). Because Twist presented no evidence of marketing that involves his identity or his name he cannot prevail on this point.

CONCLUSION

Finding that the Tony Twist character in *Spawn is* not a depiction "of and concerning" Tony Twist the retired hockey player, we conclude that the First Amendment is a bar to Twist's right of publicity claim. Because all of the legally operative facts necessary to a decision on that question were present and uncontested when the motion for summary judgment was heard, we conclude that this case should never have been tried on the merits.

While a proud hallmark of our system of justice requires that we err on the side of trial on the merits, some trials that should never have taken place, while capable of serving a role in the orderly development of the law, can in fact do more damage to our system of values than others. This is especially true where First Amendment rights are at stake.

The Supreme Court has addressed this problem and concluded that for free speech rights to be real they must have "breathing space" to prevent any "chilling effect" caused by uncertain legal rules governing what

speech is protected by the First Amendment. *Caroll v. President and Commissioners of Princess Anne,* 393 U.S. 174 (1968). This breathing space is considerable when it comes to discussion about "public officials," "public figures" and even private persons involved in "matters of public interest." The Supreme Court has said:

> Fear of large verdicts in damage suits for innocent or merely negligent misstatement, even fear of the expense involved in their defense, must inevitably cause publishers to steer wider of the unlawful zone, and thus create the danger that the legitimate utterance will be penalized.

Time, Inc. v. Hill, 385 U.S. 374, 389 (1967) (internal citations and quotation omitted).

This $24.5 million verdict makes real the chilling effect the Supreme Court references in *Time v. Hill.* And so how are we to understand such a large verdict if we are still to conclude that plaintiff failed to make a submissible case?

We understand it to be a product of the jury following the verdict directing instruction as given. They were told they must compensate a public figure for the use of his name in a presumptively protected work of fiction. But they were never instructed to apply the "of and concerning" test, which would require them to determine if a reader could believe that the *Spawn* character was meant to depict the plaintiff actually carrying out the acts described in the comic book. An affirmative answer to this threshold question is essential. For if the publication is not "of and concerning" the plaintiff, it is unnecessary to inquire further into the elements of a First Amendment defense. It is equally unnecessary to treat the elements of a state tort claim.

While rights of publicity and misappropriation of name torts are important protection for real and significant property rights, they cannot, in the order of things, prevail over principles of free expression that are at the center of our system of laws. Our ruling today should not, however, be read as an approval of the ethics of McFarlane's practice of naming characters, but leaves that to the readers and viewers of the *Spawn* story.

We hold today that the First Amendment protects the defendants' comic books, animated series and the truthful identification of the plaintiff as the inspiration for the name of the fictional character. Given this, there can be no legal ground to enjoin the McFarlane defendants from these lawful activities. The judgment notwithstanding the verdict is affirmed because this comic book and the derivative mediums utilized to communicate the *Spawn* story as conceived and created are protected by the First Amendment of the United States Constitution.

s/_____
James R. Dowd, P.J.

Paul J. Simon, J., Concurs
Mary K. Hoff, J., Concurs

Appendix C

MISSOURI CIRCUIT COURT
TWENTY-SECOND CIRCUIT
(City of St. Louis)

JOHN DOE (TONY TWIST),
Plaintiff,

V.

TCI CABLEVISION, etc., et al.,
Defendants.

Oct 31 2000

Cause No. 972-09415
Div. 3

MEMORANDUM, ORDER AND JUDGMENT

Although trial lawyers and the jury system have received harsh criticism of late, it is worth noting that a plurality of the signers of the Declaration of Independence were lawyers, mostly trial lawyers, and juries have stood between oppressive government and the ordinary citizen for centuries. Withal, juries are not infallible. When trial judges fail in their task to provide proper guidance on the law, and to screen expert evidence for objective indicia of reliability, mistakes will be made, sometimes grievous mistakes. It is with great trepidation that judges set aside verdicts of jurors, ever mindful of the dictum, *vox populi, vox Dei;* nevertheless, when a mistake is made, judges shirk their duty if they fail to rectify it.

For the reasons that follow, this Court denies Tony Twist's claim for an injunction to forbid further use of his name by defendants. Further, this Court sets aside the verdict of the jury, enters judgment notwithstanding the verdict on plaintiff's damage claim, and conditionally grants defendants' alternative motions for new trial.

Procedural History

This action was commenced in 1997 with filing of a petition alleging claims of defamation and invasion of privacy by misappropriation of name and likeness, against Todd McFarlane, various companies owned or controlled by him, Time-Warner/HBO, and a host of other comic book distributors. The case was removed to federal court, but, as so often happens, was remanded in late 1998.

This Court dismissed all defamation claims and claims for emotional distress against the defendants on motions filed during 1999 and early 2000. The Court also dismissed all claims against the comic book distributors and all other parties having no obvious connection with the McFarlane defendants, except Time-Warner/HBO. Time-Warner remained in the case because plaintiff alleged that it had exercised some creative control over the use of the plaintiff's name in the "Spawn" feature films broadcast over Time-Warner's cable television network, and the evidence on the motion for summary judgment appeared to support this allegation.

The Court initially ordered that the issue of liability would be tried first, with an advisory jury empanelled to assist the Court in determining the question. However, when it became necessary to continue the trial setting in the spring of 2000, the Court decided to try all

damage claims to a jury, with the evidence being received concurrently by the Court on the claim for injunctive relief. Thus, the case went to trial before a jury from June 19 through July 5, 2000. Time-Warner settled before the close of plaintiff's case. The Court entered a directed verdict in favor of defendants on plaintiff's claim for punitive damages. Plaintiff then decided to submit only a single claim to the jury against the remaining defendants, based on the theory of misappropriation of name.

On July 5, 2000, the jury returned verdicts in favor of plaintiff and against all defendants on plaintiff's claim for damages for misappropriation of his name. Timely motions for judgment n.o.v. or for new trial were filed by the defendants. On September 15, 2000, the Court heard arguments on these motions and received some additional evidence on the claim for injunctive relief, count VI of the amended petition.

Facts

In 1992, an obscure comic book artist launched a bizarre comic book entitled "Spawn." It was a hit, bringing substantial wealth to the artist. In the course of developing the ongoing story, the artist peopled the comic book with a variety of characters, some unsavory and most decidedly not, many of them named after people personally known to the artist, others named after professional hockey players. Many of the hockey players' names were originally drawn from the roster of a mediocre professional hockey team known as the Quebec Nordiques. In the sixth "number" of the "Spawn" series, the artist introduced a brutal, swarthy, stereotypical *mafioso*, later identified as Antonio Twistelli, a/k/a "Tony Twist." At the time of the publication of the comic book introducing the Twist character, plaintiff

Anthony Rory Twist was an obscure hockey player with the also-ran Quebec Nordiques.

Over the years, the "Spawn" comic book enterprise grew and prospered, spawning, as it were, movies, "action toys" and a variety of related comic books. In addition to defendant Image Comics, which was formed by McFarlane and several other comic book artists to provide a means to print and distribute their comic books, several other corporations were formed by McFarlane to market "Spawn" films and toys.

Similarly, the career of Tony Twist the hockey player also prospered. In 1994, he became a member of the St. Louis Blues professional hockey team. As a member of the Blues, Twist earned a reputation as an "enforcer," i.e., a player known for the ability to win brawls. He achieved a measure of national celebrity, being featured in national publications such as *Sports Illustrated*. At the same time, he engaged in many charitable activities and developed a reputation as a person interested in and willing to help disadvantaged children.

The careers of McFarlane and Twist intersected in 1997 when Twist's mother called him to express her distress at his association with the "Spawn" comic book. His mother's call was prompted by a visit from an autograph-seeking little boy, who had a trading card of the fictional *mafioso* Tony Twist. Twist investigated via the Internet, and learned more about "Spawn." He obtained the six-part cartoon video version of "Spawn" that was broadcast by Time-Warner HBO, noting with distress the prominence of the *mafioso* Twist character. Later, Twist was approached at a hockey game by another boy, who proffered a copy of *Wizard Spawn Tribute*. Pl. Ex. 1A. (*Wizard* is a sort of trade publication, being in substance a comic book review publica-

tion, not affiliated with McFarlane or his companies.) In the edition of *Spawn Tribute* proffered to him, Twist saw his own photograph juxtaposed with the fictional *mafioso* in an article in which the writer (a reporter not affiliated with McFarlane) reported that the *mafioso* character was "modeled" on the National Hockey League "enforcer," Tony Twist. Thus was spawned[1] this litigation, in which Tony Twist seeks injunctive relief and damages from Todd McFarlane and his companies. After trial of the damage claims, the jury awarded Twist $24,500,000, on the premise that the use of Twist's name was worth that much to McFarlane or has done that much damage to the marketability of Twist's name.

The evidence at trial established that the defendants have realized an aggregate revenue of approximately $124,000,000, during the entire time that the "Spawn" series has been published and marketed. Over objection, plaintiff presented the testimony of Dr. Brian Till, a marketing professor, and Rocky Arceneaux, a business agent for various professional sports players, to the effect that the use of plaintiff's name in the "Spawn" series had value to defendants. Dr. Till estimated the value of the use of plaintiff's name as high 15% of gross revenues of products in which plaintiff's "name or persona" was actually used, and as high as 9% of gross revenues for products in which Twist's "name or persona" was not used. Till testimony. Arceneaux was even more generous, asserting that the use of plaintiff's name in the context of the "Spawn" storyline carried an additional premium, and placing the value of the use of plaintiff's name at 20% of the defendants' gross revenues.

---

[1]The Court promises not to employ this pun again.

Plaintiff also presented evidence that he had obtained endorsement income during his professional career, to a maximum of about $20,000 in any one year, and that, after the commencement of the litigation, he entered into negotiations with one Sean Phillips, a consultant and sometime officer of a nutrition supplement maker known as EAS. According to plaintiff's evidence, EAS and plaintiff had a tentative agreement that plaintiff would be retained to endorse EAS products at an annual compensation of $100,000. During the negotiations, Phillips inquired of Twist if there was anything that would detract from the value of his name, and Twist informed Phillips of the "Spawn" matter. At that point, according to Phillips, he (Phillips) terminated the negotiations.

The jury's verdict reflects that the jury computed damages based on a percentage of gross revenues of the defendant, apparently accepting the Arceneaux theory of a "bonus" or "negative impact" increasing the royalty, and arriving at an aggregate figure of $24,500,000.

Count VI - Injunction

This case is in an unusual procedural posture, as a result of the Court's decision to try the damage claims to a jury, while reserving judgment on the claim for injunctive relief. The record before the jury, supplemented by a soupçon of additional evidence at the hearing on the motions following the jury's verdict, is therefore the record on the claim for injunctive relief. Because the Court is the finder of fact on the injunction claim, the jury's verdict is merely advisory on that claim. Accordingly, the Court is not bound by the jury's view of the evidence. *Mo-Kan Teamsters Health & Welfare Fund v. Clark*, 803 S.W.2d 61 (Mo. App . W. D. 1990)

The Court agrees with the jury that defendant McFarlane intentionally used the name of the plaintiff as the name of the fictional *mafioso* character in the "Spawn" comic book. The Court is willing to believe that McFarlane cannot at this time recall his exact thought process in developing and christening the *mafioso* character, but, given McFarlane's avid interest in hockey, his penchant for giving other fictional characters the names of professional hockey players, and his own published admission that many characters in the comic book were named after members of the Quebec Nordiques hockey team, it beggars credulity to accept that McFarlane's use of the name Tony Twist was a coincidence.

What is lacking on this record, however, is credible evidence that McFarlane at any time intended to injure Twist's marketability, to capitalize on the market recognition of the name Tony Twist, or in fact derived any pecuniary benefit whatsoever from the use of that name. When McFarlane first used the name Tony Twist, the plaintiff had no market recognition and was earning precisely zero income from endorsements. Later, to be sure, plaintiff became fairly well known in sports circles, but there is no evidence that plaintiff's name had any intrinsic worth as a marketing device for comic books on a national basis.

The Court has previously enunciated its views on how the common law action for invasion of privacy by misappropriation of name or likeness is affected by the constitutional freedom of the press guaranteed by the First Amendment and Mo.Const. art. I, §8. The governing principle is and must be whether the defendant, be it a "media" defendant or a common huckster of patent medicines, took from the plaintiff something of value that the defendant ordinarily could not get without

paying. When the only thing appropriated by a defendant is the plaintiff's name, there can be no right of action, outside the purely commercial or advertising context, unless the defendant intended to use the *plaintiff's* name and concomitantly intended to injure the plaintiff's marketability of his name, or in fact intended to and did derive economic benefit from the use of the plaintiff's name. The Court adheres to its previous opinions on this score.[2]

When McFarlane christened the *mafioso*, plaintiff Tony Twist was unknown to the general public. Even at the height of his own fame, plaintiff was known at best to people in St. Louis and hockey fans elsewhere. The evidence is indisputable that, prior to this litigation, plaintiff secured at best a very modest income from endorsing products or otherwise capitalizing on his name and notoriety. Indeed, the whole record reflects that, prior to this litigation, only three members of the public ever connected plaintiff with the fictional *mafioso* in "Spawn." One of these was plaintiff's mother, and another was a boy who got the idea from a publication independent of "Spawn" itself. The third person aware of the connection was Sean Phillips, who purportedly offered plaintiff an opportunity to secure an endorsement contract with a nutrition supplement marketer, EAS. In the case of Phillips, the connection was made by plaintiff himself, who notified the marketer of the ongoing litigation over the appearance of the name "Tony Twist" in "Spawn."

---

[2]It is worth noting that there is not a single reported case in which a plaintiff has been allowed to go to trial on a claim that a defendant, outside the advertising context, misappropriated the plaintiff's name. Although the Court disagrees with the superficial, knee-jerk First Amendment rationale of these cases, it is quite clear that only substantial evidence of a specific intent of the defendant can support an action such as plaintiff's here.

Plaintiff's evidence falls woefully short of anything that would justify mulcting defendants for the use of the name Tony Twist. To grant an injunction on the record before this Court would fly in the face of a long line of cases exemplified by *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46 (1988) and *New York Times v. United States*, 403 U.S. 713 (1971), and would carry the rationale of *Munden v. Harris*, 134 S.W. 1076 (Mo.App.K.C. 1911), and kindred cases to an absurd length.

The Court emphasizes that, by its reading of the law, the evidence presented that plaintiff lost a potential endorsement contract due to defendants' use of his name in "Spawn" is simply irrelevant. The question is not whether the use of plaintiff's name caused injury, the question is whether the defendants *intended* to cause such injury by using plaintiff's name. On this record, that evidence is wholly lacking.

Speaking of evidence, the Court is fain to observe that it has seldom seen less credible evidence than that presented on damages by plaintiff. The witness Sean Phillips, who purportedly aborted plaintiff's potential endorsement contract because of the "Spawn" connection, was wholly unbelievable. Prior to the proposed contract with Twist, Phillips' company, EAS, had never entered into a contract for more than $10,000 with any celebrity endorser. Phillips and plaintiff were personal friends. Phillips was not an executive officer of EAS at the time the supposed endorsement contract was bruited, and nobody else in the company hierarchy had any inkling that such a contract was in the works. See Bellamy depo. at 57. At the time this supposed contract was being negotiated, plaintiff's hockey career had been interrupted by a severe injury, probably disabling him from professional hockey in the future. Finally, the

evidence of this supposed contract first came to light on the very eve of trial.

The evidence of the witness Arceneaux was equally unworthy of belief. Arceneaux formed his opinion of the fair market value of the use of plaintiff's name on the airplane as he was flying in for his deposition. He had never represented any professional hockey players in negotiating endorsement contracts, and he could not point to one hockey player in history who commanded the royalty percentage that he attributed to the use of plaintiff's name. His own testimony concerning his experience in representing better-known football players in the matter of endorsements seriously undermined his assertion that plaintiff's name was worth a 20% royalty on gross revenues of the defendants.

In addition to the Court's finding that defendants did not intentionally use plaintiff's name for their own benefit or in fact derive any economic benefit from the use of that name, the Court concludes that injunctive relief is not available for other reasons.

First, there is the elementary issue of the adequate remedy at law. See generally *Harris v. Union Electric Co.,* 766 S.W.2d 80 (Mo.banc 1989). Albeit *Munden v. Harris* expressed the view that injunctive relief was available to suppress commercial use of a person's name or likeness, in this case the jury was instructed to award plaintiff all damages actually sustained and that the jury reasonably believed he would sustain in the future. The jury's verdict necessarily compensated plaintiff fully for the use of his name. Cf. *Pinney v. Berry*, 61 Mo. 359 (1875).

Second, there is the issue of discretion. Injunctive relief, though a familiar of our jurisprudence, is still considered to be extraordinary and granted sparingly,

and only in clear cases. Here, plaintiff would have the Court break new ground in an especially sensitive area. Defendants are not advertisers or marketers of products. "Spawn" is a work of fiction. There is no resemblance between plaintiff and the comic book Twist whatsoever, despite the specious use of the term "enforcer." The Court cannot find a single case, certainly no Missouri case, in which injunctive relief has been granted to prevent the use of a name by a writer or publisher in a work of fiction. In this case, the evidence does not clearly warrant injunctive relief, nor does it seem that such relief would not interfere with legitimate and proper action by the defendants in the future. See *Metmor Financial, Inc. v. Landoll Corp.,* 976 S.W.2d 454 (Mo.App.W.D. 1998).

Finally, there is the issue of prior restraint. While it is quite true that *Pittsburgh Press v. Human Relations Comm.,* 413 U.S. 376 (1973), holds that newspaper advertising that advances race or sex discrimination in employment can be suppressed, nothing in that case or in *Munden v. Harris* or kindred cases authorizes the sort of relief demanded by plaintiffs. Although the Court has been at pains to apply the principle of *Zacchini v. Scripps-Howard Broadcasting Co.,* 433 U.S. 562 (1977), to the case at bar, see also *Cohen v. Cowles Media Co.,* 501 U.S. 663 (1991), the Court considers that, outside the purely commercial advertising context, the Court is barred by the Constitution to enter an injunction constituting a prior restraint-absent copyright or trademark infringement. Cf. *New York Times Co. v. United States,* 403 U.S. 713 (1971).

The Jury's Verdict

As intimated above, the Court's view of the evidence is wholly at odds with the view of the jury. Ordinarily, this difference would be of no moment, as the Court

would be obliged to view the record in the light most favorable to the jury's verdict and deny judgment n.o.v. if there was any evidence in the record that would enable a rational jury to arrive at the verdict rendered. Because the Court is the trier of fact on count VI, however, this stricture is not controlling.

Assuming that the Court must review the jury's verdict on the damage claim in light of the principles governing grant of motions n.o.v., the Court is nonetheless convinced that the critical evidence needed to support the jury's verdict is absent.

As the Court has adumbrated above, because the defendants used plaintiff's name only, in the context of a work of fiction outside the purely commercial medium, plaintiff could prevail only by adducing substantial evidence of a specific intent by defendants to use his name for their benefit or to his detriment, coupled with evidence that some economic benefit was n fact derived from the use of the name or some specific economic injury was intentionally inflicted on plaintiff. The evidence supports no such findings. Indeed, plaintiff's own witness, Dr. Till, summarized the plaintiff's failure of proof rather neatly:

> Q. I understand. And you're not giving an opinion, are you, that Mr. McFarlane, because he used the name increased his revenues by 15 percent, are you?
>
> A. No, I'm not.
>
> Q. In fact, do you have any opinion as to whether or not Mr. McFarlane sold any comic books that he wouldn't otherwise have sold by using Mr. Twist's name?

A. I can't relate sales of the Spawn products directly to the use of Mr. Twist's name.

Q. You haven't attempted to determine that, have you?

A. It's essentially undeterminable.

Q. So in your opinion, you don't know.

A. I don't know what effect the use of Tony Twist's name or persona has had on Spawn products. [Till Testimony; Draft Tr. 136-37.]

The plain fact of this case is that plaintiff's sole reliance is on the evidence of the intentional use of his name, plus speculation concerning some "value" the bare use of the name had. In light of the context in which plaintiff's name was used, i.e., a work of fiction in which no connection between the real plaintiff and the *mafioso* Twist ever appears, plaintiff must present far more in order to prevail on the misappropriation theory. Cf. *Bayer v. Ralston Purina Co.*, 484 S.W.2d 473 (Mo. 1972).

Even assuming that the jury was correctly instructed on plaintiff's theory, the jury was required to find either that defendants "derived advantage from the use or publication of plaintiff's name, or plaintiff suffered harm as a result." Instruction No. 7. Because the evidence wholly fails to support these propositions, judgment must be entered for defendants. (The Court omits discussion of the patent absurdity of holding the corporate defendants liable for damages inflicted prior to their existence, and the very real absence of evidence to support the claim against Image Comics, which served purely as a publishing conduit and exercised no editorial control over publications that it handled for the creators.)

New Trial

Rule 72.01(c) (1), Mo. R.Civ.P., prescribes that a trial court shall rule on any motion for new trial filed with a motion for judgment n.o.v. that is granted. Rules 72.01(c) (1) and 78.03 require the Court to specify grounds on which a new trial is granted. Rule 78.08 allows consideration of plain error, though defectively raised.

Defendants have raised several errors warranting a new trial. The principal error asserted is instructional: the Court misdirected the jury on the law governing defendants' liability. As the discussion above foreordains, the Court agrees that it did so err.

The verdict-directing instructions in this case omitted any requirement that the jury find that defendants specifically intended to use plaintiff's name for their economic benefit or specifically intended to injury plaintiff's marketability of his name. The instructions also omitted any direction to the jury to find that defendants in fact had appropriated the commercial value in the use of plaintiff's name. In instructing the jury in accordance with the verdict directing instructions ultimately submitted by plaintiff, the Court departed from the principles laid down in its Order of April 10, 2000, denying summary judgment. Attempting to harmonize *Zacchini* and *Falwell,* this Court concluded that the Constitution demanded evidence of a very specific intent--much as the Constitution commands very specific intent in order to sustain claims for defamation in the context of publications concerning public figures or events. The Court simply did not give such instructions to the jury. Rather, the Court allowed the jury to attach almost any meaning to "value" and, worse, allowed the jury to impose liability solely for intentional use of a name, without the concomitant intent to obtain benefit or to injure. Defendant's pro-

posed verdict directing instructions were more nearly correct. In any event, plaintiff's verdict directing instructions were hopelessly broad and inaccurate. Moreover, in instructing the jury to find for plaintiff if defendants either derived advantage or inflicted harm, the Court erred, since the evidence that defendants derived any advantage from the use of plaintiff's name is absent. Even accepting the patently false testimony of Phillips, as the jury evidently did, the disjunctive submission warrants a new trial. *M.C. v. Yeargin,* 11 S.W.3d 604 (Mo.App.E.D. 1999).

The Court also misdirected the jury in the matter of damages. Although *Munden v. Harris, 134 S.W.* 1076 (Mo.App.K.C. 1911), contemplates the award of general and special damages, the Court is conscious that the essence of a claim of invasion of privacy by misappropriation of name is the appropriation of commercial advantage in the use of another's name, i.e., the unfairness of allowing a defendant to derive economic advantage, or to inflict economic harm, from the use of a property right of the plaintiff. By allowing the jury to consider all defendants as equally liable for purposes of computing damages, the Court permitted the jury to award damages for conduct occurring before several of the corporate defendants came into existence, and also for conduct that had nothing to do with the use of plaintiff's name, i.e., the marketing of action figures, none of which were derived from the comic book Twist character. In keeping with the limitations on this cause of action delineated above, the Court should have instructed the jury to award damages based specifically on the benefit derived by each defendant from that defendant's own conduct, or on the specific injury that each defendant inflicted on plaintiff's marketability.

The Court likewise erred in admitting the testimony of Dr. Till and Rocky Arceneaux. Although they qualified as experts, their opinions lacked foundation sufficient to justify admission under §490.065, RSMo 1994. There was no evidence of any recognized market for product endorsements by hockey players, no evidence of any royalty previously attributed to the use of plaintiff's name in product endorsements, no evidence that the use of any hockey player's name in a work of fiction would have discernible effect on the market, and no evidence of any empirical studies showing that a hockey player's endorsement would have any effect on the marketing of any product, much less the marketing of a comic book and action figures that bear no resemblance whatever to hockey players. The opinions and methods of Till and Arceneaux are at best "junk economics": they certianly are not science (the same could be said of the testimony of the defendants' experts, but that is not the issue). They are exercises in speculation. The Court should have sustained defendants' motions in limine to exclude the evidence of Till and Arceneaux, and should have sustained defendants' timely renewed objections at trial. §490.065, RSM0 1994; *M.C. v. Yeargin*, supra.

There can be no doubt that the admission of the testimony of Till and Arceneaux prejudiced defendants, since the jury's verdict on its face shows calculations in keeping with the testimony about the percentage of gross revenues attributable to the value of plaintiff's name. Because of this error, the verdict cannot stand.

Finally, the Court must in good conscience hold that the verdicts in this case are against the manifest weight of the evidence. No rational person could believe that the use of plaintiff's name as the *nom de guerre* of a swarthy *mafioso* in a comic book series, having abso-

lutely nothing to do with hockey, either benefited defendants or injured plaintiff in any way, except perhaps in plaintiff's imagination.

The fatal flaw in plaintiff's case is the belief that the mere intentional use of the plaintiff's name, coupled with the bare "advantage" of using one combination of syllables versus another, is sufficient to fasten liability on the creator of a work of fiction. In this case, given the fictional context, the complete absence of demonstrable pecuniary value to the defendants, and absence of any demonstrable intent to inflict economic harm on the plaintiff, plaintiff's case must fail.

ORDER AND JUDGMENT

For the foregoing reasons, it is

ORDERED, ADJUDGED AND DECREED that defendants Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc., Todd McFarlane Entertainment, Inc., and Image Comics, Inc., have judgment against plaintiff on count VI of the plaintiff's amended petition, which count VI is dismissed with prejudice; and it is

FURTHER ORDERED, ADJUDGED AND DECREED that the verdict of the jury herein in favor of plaintiff on plaintiff's claim for damages be and the same is hereby set aside and judgment notwithstanding the verdict is entered in favor of defendants Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc., Todd McFarlane Entertainment, Inc., and Image Comics, Inc., on all claims for misappropriation of name, and all remaining counts of the amended petition are dismissed with prejudice; and it is

FURTHER ORDERED that, in the event the judgment notwithstanding the verdict herein be reversed, vacated or set aside, the alternative motions for new trial of defendants Todd McFarlane, Todd McFarlane Productions, Inc., TMP International, Inc., Todd McFarlane Entertainment, Inc., and Image Comics, Inc., are granted, and a new trial is ordered on plaintiff's claim for misappropriation of name as alleged in the amended petition for the following reasons: (a) the verdict of the jury was against the manifest weight of the evidence; (b) the Court erred in instructing the jury in accordance with verdict-directing instructions 6, 8, 10 and 12 and in refusing defendants' proffered instructions D, E, F and G; (c) the Court erred in instructing the jury to return a verdict assessing damages against the defendants jointly and severally and in permitting the jury to consider in its damages computation sums realized by defendants prior to the use of plaintiff's name in any manner; and (d) the Court erred in admitting the testimony of Brian Till and Rocky Arceneaux on the issue of damages; and it is

FURTHER ORDERED that defendants' alternative motions for new trial or for remittitur are otherwise denied; and it is

FURTHER ORDERED, ADJUDGED AND DECREED that all claims and parties having been disposed of, final judgment is hereby entered in favor of each and every defendant and against plaintiff on all claims alleged in the amended petition, which is dismissed in its entirety with prejudice; costs taxed against plaintiff.

SO ORDERED:
s/_____
Robert H. Dierker
Circuit Judge

Dated: 31 Oct., 2000
cc: All counsel